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Supreme Court, U.S.
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No. 081071

IN THE
Supreme Court of the United States

Asokkumar Pal, pro se

Petitioner

v.

Department of Commerce

Respondent

ON PETITION FOR A WRIT OF CERTIORARI TO THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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February 14, 2009

QUESTIONS PRESENTED FOR REVIEW

Did the U.S. Court of Appeals for the Federal Circuit ("court") violate petitioner's constitutional rights of the due process and equal protection of the laws, by issuing a decision under the deferential substantial evidence standard to agency's factual findings, the process of selection of the work products, and allegation of errors by the agency, and without *de novo* review – without deference – of agency's underlying ultimate legal determination on patentability issues, as required by the law and court's precedents, when the agency alleged at least three errors after reaching conclusion requiring legal interpretation of the underlying factual findings?

By concurring with agency's legal conclusions under 35 U.S.C. § 103 and 35 U.S.C. § 112, 1st paragraph, description requirement – conclusions the agency relied on to justify agency's allegation of the three errors – did the court violate its long-standing precedents?

When a patent applicant appeals from the PTO board's decision, the court reviews obviousness and claim construction issues de novo; did the court violate petitioner's rights to receive equal treatment under the law in petitioner's appeal from the decision of a board (MSPB)?

PARTIES TO THE PROCEEDING

The caption of this case contains the names of all parties.

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OPINIONS BELOW

On December 8, 2008, the United States Court of Appeals for the Federal Circuit ("court") issued the non-precedential decision, affirming Merit Systems Protection Board ("board"), which is reprinted in the appendix to the petition at pp. 1-8 ("App. 1-8").

On January 6, 2009, the court issued an order denying Pal's timely filed petition for panel rehearing for review of the overlooked and misapprehended arguments – already present in Pal's principal brief and the reply brief – regarding the agency's ultimate legal determination, which the court reviews without deference. App. 9

On January 26, 2009, the court issued an order denying the motion and the petition for en banc rehearing. App. 10

STATEMENT OF JURISDICTION

The Initial Decision of the administrative judge was issued on July 27, 2007, and an erratum on July 31, 2007. The Final Order of the board was issued on February 6, 2008.

The Federal Circuit court's jurisdiction was founded upon 29 U.S.C. §7703.

The petition for review was timely filed to the court pursuant to 5 U.S.C. §7703(b)(1).

The court issued its decision on December 8, 2008, affirming the board. App. 1-8

The court denied a timely filed petition for panel rehearing on January 6, 2009. App. 9

The court denied a timely filed motion and petition for rehearing en banc on January 26, 2009. App. 10.

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISIONS INVOLVED

U.S. Constitution, Amendment. XIV, § 1:

> All persons born or naturalized in the United States, and subject to the jurisdiction thereof, are citizens of the United States and of the State wherein they reside. No State shall make or enforce any law which shall abridge the privileges or immunities of citizens of the United States; nor shall any State deprive any person of life, liberty, or property, without due process of law; nor deny to any person within its jurisdiction the equal protection of the laws.

STATEMENT OF THE CASE

The agency removed Pal for one reason only: Pal had an error rate greater than 25 percent during the performance improvement period ("PIP").

On August 3, 2006, OPQA Director Paula Hutzell ("Hutzell") issued the Notice of Proposed Removal, alleging six errors in 16 work products; Pal's supervisor Diana Dudash ("Dudash") reviewed 16 work products from a total of 139 work products that Pal completed during the seven bi-week PIP.

The agency had set only one requirement at the beginning of the PIP that, in order to avoid removal, Pal could not have an error rate greater than 25 percent (i.e. no more than 4 errors in 16 cases).

On November 3, 2006, deciding official Margaret A. Focarino ("Focarino") removed Pal[1] alleging that Pal, having made six errors in 16 work products during the PIP, failed to meet the only requirement set by the agency for the PIP: 25 percent or less error:

---

[1] Petitioner Pal served in the PTO for 25 years; the agency graded his performance "Outstanding" for straight 22 years, followed by "Commendable" for last two years. In 2005, new OPQA Director, four months in the position, rated Pal's performance Unsatisfactory, and started the removal process.

At deposition in April 2007, after Pal's removal, the Director admitted that the performance data used in 2005 (to support Pal's Unsatisfactory rating) were wrong. Had the agency relied on correct data, Pal would have been rated Marginal. The agency does not place an employee in an improvement period – leading to removal – when the employee is rated Marginal.

Pal has M. Tech degree in Chemical Engineering & Chemical Technology (Calcutta U., 1968), MS in Chemical Engineering (U. of Illinois, Urbana, 1981), and MS in Biotechnology (Johns Hopkins, 1998). Pal is now a registered Patent Agent, authorized to practice at the U.S. Patent Office.

> "While your performance in the critical element *Training* improved, your performance in the critical element *Quality Monitoring* did not. ... During the improvement period, which began December 11, 2005, and ended March 18, 2006, your quality error rate was 37.5%. You were required to achieve at least the Marginal level of performance by having an error rate of no more than 25%. ...
>
> "I conclude that your performance was unacceptable in the critical element *Quality Monitoring*, and that removal is the appropriate action under the authority of 5 U.S.C. § 4303" (Emphasis original).

During the hearing (April 2007), Focarino testified, and reconfirmed her "decision to remove Mr. Pal from his position:"

> "Because the proposed removal was based on an error rate that was, I think, in the high 30 percentile and therefore his work was unsatisfactory and ... so I sustained the removal."

The court, in its decision, recognized the same – and only – reason for Pal's removal:

> "Pal understood that to avoid an 'Unacceptable' grade for his work during the PIP, he could not have an error rate greater than 25 percent." App. 3.

Pal's task throughout the appeal – at the agency, before his removal, and, after removal, in the legal process – was to establish that at least three errors, alleged after agency's ultimate legal conclusion, were not in accordance with the law and, therefore, were non-errors, and that, at 4 or 3 errors in 16 cases, he had an error rate 25 percent or less.

Higher officials at the agency never responded to Pal's appeals for a review of Dudash's allegations of three errors, based on her legal determinations which the agency would have found unacceptable and not in accordance with the law.

In fact, as will be discussed later, the agency's examining group, which finally determines rejection of the claims, or recommends to the Agency Director for issuance of patent on allowed claims, rejected Dudash's legal conclusions that were the basis for two alleged errors. The agency, in effect, ultimately agreed with Pal's positions.

Pal timely appealed to the court, emphasizing the legal issues in each case, and seeking review of the board decision. Brief excerpts. App. 24-32, Reply brief excerpts. App. 37-47.

Pal presented arguments in his principal brief on two sets of issues:

(a) Patentability issues, on a case-by-case basis – that agency's allegations of at least three errors were not in accordance with the law, and were in violation of the court's precedents. App. 24-32.

(b) The general process of non-random selection of the 16 cases for review was unfair in view of MSPB precedents; record shows that the agency rated five similarly positioned reviewers differently at error rates greater than 25 (even at 35.7, 50) percent[2].

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[2] Just a few months ago (October 2005) under a performance appraisal plan (PAP 2005), during appraisal of the reviewers, Hutzell rated five other reviewers (out of seven) Outstanding or Commendable (one Fully Successful), even when they had error rates greater than 25 percent; none was placed in a PIP. Hutzell rated two reviewers Commendable even at their error rates 35.7 and 50 percent, while she rated Pal unacceptable at 34 percent error rate. PAP 2005 was essentially identical with the PAP 2006 that was in effect during the PIP,

The panel affirmed the board only with respect to the process (in 2005 the agency had rated other reviewers differently at their error rates much greater than 25 percent), under "substantial evidence" standard of review. APP. 6.

In affirming the board's decision, the panel concluded that substantial evidence standard stood in the way of Pal's arguments with respect to the process; the panel decision states:

> "We agree with the Board, and we see nothing unfair or unlawful in the way the agency selected which of Pal's work during the PIP period would be tested." Pet. App. at 6.

The court additionally observed that:

> "Pal also contends that those who graded his work did not understand, and indeed misapplied, the law he applied when he graded the individual examiners. In other words, Pal asserts that the judges[3] were inadequate to the task, since they made errors in judging Pal's work. The substantial evidence standard of review stands in the way of Pal's criticism of his judges. ...
>
> "Pal has provided the court with extensive briefs that present further arguments that challenge the PIP process itself and the judgments reached by those who judged his work and finally ordered his removal. We have reviewed each of those arguments with care. Pal's arguments present no reversible error. Substantial evidence shows that the process was fair and that on the record as a whole, a reasonable mind could reach the same conclusion as reached by the Board." App. 7.

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[3] Agency officials who graded Pal's work products during the PIP.

Nowhere in the court's decision, did the panel judges make any comment with respect to the percent error rate – the key determinant in removal – and agency's underlying legal conclusions.

In the Notice of Proposed Removal, the agency relied on its legal conclusions – on a case-by-case basis – to support the agency's finding of errors in at least three cases. Excerpts App. 51, 58-60, 69-70.

After court's decision, Pal filed petition for panel rehearing (the court later denied), emphasizing that the court might have overlooked Pal's arguments with respect to the patentability issues and the court did not address the percent error rate. App. 11-23.

Pal emphasized in the brief (Section VI) that agency alleged at least three errors supported by agency's legal conclusions, based on agency's underlying factual findings. App. 24-32.

During trial, Pal testified and presented legal arguments – on a case-by-case basis – to establish that the agency's legal ultimate conclusions were not in accordance with the law.

Pal submitted Exhibits to the administrative judge summarizing the facts, and the law, supported by MPEP citations and precedents of the court. True copies: App. 52-53, 60-61, and 67-68.

The agency received the Exhibits in advance of the trial; however, the agency counsel at the hearing did not contradict Pal's testimony, or Pal's legal arguments in the Exhibits. When the agency counsel recalled Dudash, after Pal's testimony, the agency counsel did not seek her rebuttal testimony to Pal's counter-arguments. App. 69.

In respondent's answer, agency counsel did not present any rebuttal to Pal's legal arguments in Pal's brief with respect to the patentability issues.

Rather, the agency counsel presented arguments directed to the "process" of selection of the cases, and argued that, in view of the fact that five patent professionals testified and concurred with Pal's supervisor, "great deference [the reviewing court] owed to the agency because of scientific and technical nature of the work at issue." App. 33-36

In other words, the agency counsel argued that the court must affirm the board because the panel judges at the court would not understand the science and technology, and must rely on agency's factual findings (five agency officials concurred) under the deferential substantial evidence standard. App. 36.

Agency counsel additionally argued that an independent, de novo, review of agency's conclusions (e.g., the ultimate legal determinations the agency relied on in alleging the errors) by the court was not necessary; the counsel implied that such a review would be against the law, and the court must decide under the highly deferential substantial evidence standard alone. Agency counsel argued:

> "Mr. Pal disputes that the remaining four errors with which he was charged were, in fact, errors. Before the board, Mr. Pal failed to address the agency's contentions in a direct manner that would have allowed the administrative judge to evaluate his arguments." App. 35

As discussed before, Pal submitted Exhibits summarizing the facts, the law, relevant MPEP sections, and the Federal Circuit precedents for the administrative judge to weigh in the Pal's testimony. The agency received the Exhibits ahead of the trial, and did not disagree. App. 52-53, 60-61, 67-68.

The agency counsel and the patentability expert did not challenge Pal's testimony; when they recalled Dudash after Pal's testimony, they did not seek rebuttal from Dudash. App. 69.

Pal re-emphasized in the reply brief that the central points of contention between the agency and Pal, in three cases, were the legal determinations by the agency that led to agency's allegation of the errors, and that, by law, "reviewing court shall decide all relevant questions of law..." 5 U.S.C. § 706. The court reviews legal determinations without deference. App. 37-47

If, in case of two or three alleged errors, the court, after review without deference, had found that agency's legal determinations were not in accordance with the law, Pal would have had four or fewer errors, and the court was expected to reverse the board.

SUMMARY OF THE ARGUMENTS

As stated above, Pal sought judicial review by the court on two sets of issues:

(a) Patentability issues: two cases under 35 U.S.C. § 103 (obviousness); and one case under 35 U.S.C. § 112, 1st paragraph, description requirement (new matter).

(b) Whether the process of selection of the sixteen cases was fair and acceptable in view of the board's (MSPB) precedents, and whether other reviewers, rated Outstanding or Commendable, could achieve error rates lower than 25 percent.

The court directed its decision exclusively to the process of selection of the cases under the highly deferential substantial evidence standard, i.e. directed only to agency's underlying factual findings.

The court decision says nothing about the percent error rate – the sole determinant in Pal's removal.

The court overlooked Pal's arguments that the agency alleged at least three errors only after the agency made ultimate legal determinations; by law, and as a matter of its policy, the court reviews legal determinations without deference.

Alternatively, the court, after review, adopted agency's legal conclusions as its own, in which case the court decision represents a radical departure from its long-standing precedents.

For simplicity, petitioner Pal will present reasons for granting the petition for a writ of certiorari to the court, as related to the court's decision that overlooked or misapprehended agency's ultimate legal conclusions, which the court was required to review without deference.

The court overlooked that the agency, in the Notice of Proposed Removal, presented the legal conclusions to support the allegations of errors and to support the percent error rate above 25 percent.

When relevant questions of law are present, the standard of review at the court is very clear:

> "To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions..." 5 U.S.C. § 706

The court also recently clarified and established its review policy of a board/agency decision:

> "We review ultimate legal determination of obviousness without deference...We review factual findings underlying this determination for substantial evidence." *In re Zurko,* 258 F.3d

1379, 59 USPQ2d 1693 (Fed. Cir. 2001), *on remand from Dickinson v. Zurko,* 527 U.S. 150 (1999).

In *In re Gartside,* 203 F.3d 1305, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000), the court stated:

> "Whether a claimed invention is unpatentable as obvious under Section 103 is a question of law based on underlying findings of fact. *See In re Dembiczak,* 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)... The Board's legal conclusion of obviousness is reviewed *de novo. See In re Rouffet,* 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998) *see also* 5 U.S.C. Section 706 (1994) ('To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law...') Although we have previously reviewed the Board's factual determinations in an obviousness analysis for clear error,...we now review them for substantial evidence." (citation omitted).

The court has stated in the decision: "We have reviewed each of these [Pal's] arguments with care. Pal's arguments present no reversible error." App. 7.

If the court affirmed the board adopting that the board's legal conclusion were in accordance with the law, and as the basis for the court's decision, then the court has radically departed from its precedents.

ARGUMENTS

I

The court affirmed the board on the basis of agency's final legal conclusions with respect to the obviousness issues in agency's alleged two errors – in applications **10/640,364** and **10/612,149**

In **10/640,364**, Pal's supervisor Dudash charged an error to Pal alleging that Pal had improperly raised an In-Process Examination Deficiency ("IPED") in examiner's rejection under 35 U.S.C. §103, that was under Pal's review. App. 58-60.

When the applicant rebutted the examiner's rejection under 35 U.S.C. §103 (obviousness), on the same grounds as Pal had proposed in the IPED, the agency's examining group, which finally determines patentability or rejection of claims, withdrew the rejection, and allowed the claims. In other words, the agency rejected Dudash's initial decision, and adopted Pal's proposed IPED.

The record shows that the agency's examining group, by allowing the claims, had effectively found an IPED in the examiner's rejection, and implicitly agreed with Pal, even before the agency issued Pal's removal notice. There was no justification for the agency to maintain the error against Pal and include in the Notice of Proposed Removal, after the agency's examining group rejected Dudash's position.

As discussed later in detail, Pal found the examiner's rejection of the claims under 35 U.S.C. §103 – which Pal's supervisor Dudash approved – was unacceptable in view of the court's precedents: (1) The primary references did not teach the claim limitations (such as, ion exchange resin bed, chemical interactions); (2) Dudash approved examiner's rationalization without an evidence on record; (3) Dudash approved the impermissible combination of the primary references (teaching addition of beneficial additives to a fuel, but not the ion exchange resin, or chemical interactions involved) with a conflicting prior art that taught the opposite process (removal of contaminants from a fuel with an ion exchange resin bed). App. 57-58

The court, in its decision, did not "review [agency's] ultimate legal determination of obviousness without deference." Alternatively, if the court adopted board's conclusion with respect to obviousness as its own, the court decision would be a radical departure from its precedents.

In **10/612,149**, Pal considered the examiner's rejection of claims 5-10 acceptable, and made the case "pass-through," i.e. not an IPED. In his rejection, the examiner cited and followed the same rationale as the court had established in the court's precedent under identical fact-situation.

Dudash thought otherwise, charged an error to Pal for failing to propose an IPED in the examiner's obviousness rejection under review. App. 69-70.

Dudash herself took the initiative to propose an IPED; she went against agency's MPEP and the court's precedent. She ultimately failed to convince the examining group to accept her position.

The examining group refused to incorporate her proposed IPED into the rejection under review, and also in subsequent examiner's rejections of the same claims.

In defiance, the examiner repeated the same rejection verbatim thrice. The administrative judge entered the latest verbatim rejection as an Appellant's Hearing Exhibit no. 2. App. 68-69.

When the December 2005 rejection is compared (App. 64-65) with the January 2007 rejection (App. 66-67) the only differences are editorial changes (at lines 6 and 7 of the text, highlighted). App. 66.

By repeatedly refusing to adopt Dudash's IPED position, the agency effectively agreed with Pal's original position of "no IPED." Even after failing at the examining group, before the removal letter, Dudash continued to charge the error to Pal.

Pal was a bystander, while Dudash attempted to issue an IPED, and failed to prevail at the agency's examining group – thrice.

The court decision, by affirming Dudash's legal conclusion, in effect, contradicts court's own precedents in obviousness.

II

The court reviews claim construction issue without deference. *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994).

In the third application **10/724,596**, the examiner rejected two new claims containing the limitation "one of the terminals is formed from aluminum" under 35 U.S.C. §112, 1st paragraph, description requirement, as new matter, lacking support in the original specification. App. 48-54

Pal showed literal support in applicant's original specification: "Terminals 3 and 4 are aluminum." Even Dudash initially agreed, that "terminals formed from aluminum." App. 50

Both Dudash and Pal agreed that the applicant had possession of the later claimed subject matter, and had met 35 U.S.C. 112, 1st paragraph, description requirement (new matter). App. 50

Under 35 U.S.C. 112, 1st paragraph, description requirement, Pal had met his burden to show support in the original disclosure for the subject matter later claimed, and properly called examiner's rejection an IPED.

Even then, Dudash charged an error to Pal by bringing in claim indefiniteness issues: claims imply that the other terminal could be something else. App. 50-51

By affirming the board decision, the court has effectively decided in contradiction with its precedent.

III

Each of the three errors involved separate and distinct legal issues, and was separately discussed in agency's Notice of Proposed Removal; the legal issues were individually testified by Dudash, and by Pal at the hearing before the administrative judge.

To determine the percent error, each error – alleged by the agency after an ultimate legal determination – must be individually determined by the court, without deference, whether the specific error was in accordance with the law.

The critical question before the court was whether Pal actually made more than four errors in a sample of 16 cases, and whether Pal really had an error rate greater than 25 percent.

The court decision is totally silent about the issue. The court failed to follow the law. Legal issues cannot be decided under the substantial evidence standard alone.

Pal timely sought panel rehearing and filed a petition pointing out that the panel overlooked or misapprehended Pal's major arguments with respect to patentability and error rate, and that the law and the court precedents required the court to review agency's ultimate legal determination, when presented as an issue, without deference.

The court denied Pal's petition for panel rehearing. Pal timely filed petition for rehearing en banc; the court denied the petition for rehearing en banc.

IV

Pal deserves an equal treatment under the law at the court.

When a patent applicant appeals from the adverse decision of the PTO Board of Patent Appeals and Interferences ("BPAI") affirming the examiner's final rejections of claims under 35 U.S.C. §103, and §112, irrespective of the process (prosecution at the agency) leading up to BPAI's decision, the court reviews BPAI's ultimate legal determinations de novo, without deference, and the agency's underlying "factual determinations...for substantial evidence:"

In *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000), the court stated:

> "Whether a claimed invention is unpatentable as obvious under Section 103 is a question of law based on underlying findings of fact...Although we have previously reviewed the Board's factual determinations in an obviousness analysis for clear error,...we now review them for substantial evidence." (Citations omitted).

Here, in an identical situation, Pal appealed from an adverse decision by a board (MSPB) alleging at least three errors, where the board justified the allegation of the three errors after an ultimate legal determination (by Dudash), first, under 35 U.S.C. §103, and, secondly, improperly raising issues legally considered under 35 U.S.C. §112, 2nd paragraph.

Pal was entitled to have court's judicial review – without deference – of agency's legal conclusions.

Instead, the court affirmed the board decision with respect to board's factual finding (with respect to the process of selection of cases for review) under the deferential substantial evidence standard.

In two situations, the evidence show, agency's own examining group Directors rejected Dudash's initial positions with respect to obviousness issues, and ultimately accepted Pal's position, even before the agency issued the letter of removal. In the Notice of Proposed Removal, the agency had no justification to continue to hold the "errors" against Pal.

V

The agency alleged two errors after the agency made an ultimate legal determination with respect to obviousness of the claims at issue. In the Notice of Proposed Removal, Director Hutzell clearly raised the legal issues to support the allegation of two errors. App. 58-60, 69-70.

When an applicant files an appeal from a decision of the PTO Board of Patent Appeals and Interferences (BPAI), the court reviews obviousness patentability issues de novo. *In re Donaldson Company, Inc.,* 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994, in banc) ("Obviousness under section 103 is a question of law that this court reviews de novo."); In re McCarthy, 763 F.2d 411, 226 USPQ 99 (Fed. Cir.1985); *In re Bell,* 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993) ("We review an obviousness determination by the Board *de novo.*"); *In re Klein,* 987 F.2d 1569, 26 USPQ2d 1133, 1134 (Fed. Cir. 1993) ("Obviousness is a question of law based on underlying facts and our review is de novo when the issue before us is whether a question of law has been correctly decided. *In re Woodruff,* 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990)").

Following the decision of the Supreme Court in *Dickinson v. Zurko,* 527 U.S. 150, 50 USPQ2d 1930 (1999), the court continues to review obviousness patentability issues de novo, without deference. *In re Gartside,* 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000); *In re Baker Hughes, Inc.,* 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000); *In re Zurko,* 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001), *on remand from Dickinson v. Zurko,* 527 U.S. 150, 50 USPQ2d 1930 (1999) ("We review the ultimate legal determination of obviousness without deference ...

We review factual findings underlying this determination for substantial evidence.")

A

10/640,364

App. 55-61

Respondent's brief repeated Dudash's testimony only, but did not present a rebuttal to Pal's argument in the brief. App. 35.

Background: The examiner rejected the claims under 35 U.S.C. §103 as obvious over Rohrbach in view of Drozd and Graiff. App. 55

The examiner noted, and Dudash acknowledged, and agreed with Pal that Rohrbach and Drozd did not teach the claim limitations:

> "an ion-exchange resin to which a fuel additive is removably bound by a chemical interaction, wherein the ion-exchange is selected from the group consisting of anionic exchange resins and cationic exchange resins, and wherein the fuel additive is at least partially removed from the ion-exchange resin by means of a chemical interaction." App. 55

The examiner rationalized, and Ms. Dudash agreed that it was proper, that, even though Rohrbach and Drozd did not disclose ion-exchange resin:

> "Rohrbach et al suggest materials functionally similar to "ion-exchange resin" by disclosure of "high surface area and surface modified sorbents: that may have "high binding acitivities" [sic] and may be of resin forming polymeric material "organic salts...amines, polyamines, polyimines..." and neutralizing agents including zeolites and modified zeolites and activated carbon (column 7, lines 45-49 and

> 61-67). Drozd et al further suggest "ion-exchange resin" by teaching of mixture of adsorbents and thermoplastic resins" (column 13, lines 6-10)." App. 56

However, Graiff taught the opposite process (using an ion exchange resin to remove impurities from a fuel composition), while the Rohrbach and Drozd processes taught the addition of beneficial components into the fuel composition, the same objective as in applicant's process:

> "Graiff teaches purification of fuels prior to their use/combustion in engines, by passing the fuel through a bed containing adsorbents including one or more of activated carbon, zeolites and ion exchange resins at least of the anionic exchange type (especially column 2, lines 2-41." App. 56

The examiner, unable to find a teaching of ion exchange resin in primary reference Rohrbach, rationalized:

> "Thus, it would have been obvious to one of ordinary skill in the art to either have considered the additive releasing sorbents of Rohrbach et al to encompass "ion exchange resin" or to supplement or substitute with ion exchange resin, since Drozd et al teach that additives are controllably released, at a well controlled rate (see further column 2, lines 34-36 of Drozd et al) from mixtures of adsorbents and thermoplastic resins (i.e. resins having ion containing fuel impurity adsorbent properties[)], the impurities being adsorbed being exchanged with the fuel additive; and since Graiff et al teach that each of activated carbon, zeolites and ion exchange resins reduce

> various types of fouling, gumming and deposits present in the fuel." App. 56-57

The examiner invoked common sense or possible alternatives, without an evidence supporting the rationale.

Board's Final Decision: Pal made a legal error by calling the examiner's rejection unacceptable (IPED) in accordance with 35 U.S.C. §103:

> "Upon review by the Supervisory RQAS, it was determined that the prior art references cited in the [35 U.S.C.§] 103 rejection did meet the limitations of the claims." App. 58-59

Board's Final Decision was not in Accordance with the Law:

References did not teach the claim limitations, except Graiff taught the ion exchange resin; but, Graiff used the ion exchange resin to remove contaminants from a fuel – the opposite of what Rohrbach taught and the applicant intends to do.

Examiner made an impermissible combination of conflicting references. Examiner failed to treat Graiff teachings *as a whole* (Graiff would have destroyed the Rohrbach process). The court has observed:

> "It is impermissible to pick and choose from one reference only so much of it as will support a given position." *In re Hedges*, 783 F.2d 1038 (Fed. Cir. 1986); *In re Gurley,* 27 F.3d 551 (Fed. Cir. 1994)."

Examiner's rationalization was not based on evidence in the record, and lacked substantial evidence. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). In *Zurko*, the court stated in a similar situation:

> "This assessment of basic knowledge and common sense was not based on any evidence in the record, and, therefore, lacks substantial evidence support. ... the Board [BPAI] cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point out to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise."

Finally, agency's examining group, TC1700, withdrew examiner's rejection when the applicant rebutted the same way as Pal did, reversing Ms. Dudash's original position that the rejection was acceptable under 35 U.S.C. §103.

The panel decision contradicts this court's precedents:

Examiner argued, and Ms. Dudash adopted the notion, that "one of ordinary skill...[would] have considered the additive releasing sorbents of Rohrbach et al to encompass 'ion exchange resin.'"

Without an evidence on record, Dudash's position was not in accordance with *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

B
10/612,149
App. 62-70

In his brief, the agency counsel did not rebut to the patentability issues argued in Pal's brief.

Background: The examiner made an excellent rejection of claim 1 (anticipation under 35 U.S.C. §102) identifying each of applicant's claimed apparatus components in Okase; the Okase apparatus functioned essentially the same way as applicant's claimed apparatus.

However, the examiner did not find teachings of applicant's self-designed preferred formula limitations in dependent claims 5-10. App. 62-63

The applicant did not establish the criticality of the formula limitations, or showed an unexpected result, while using the components taught in Okase, and the claimed apparatus, and performing the same function as in Okase.

The examiner properly rejected claims 5-10 as obvious over Okase, invoking the rationale decided by the court under similar fact situation.

Pal found no fault in examiner's (December 2005) rejection of claims 5-10, since the examiner relied on the court's rationale under very similar fact-situation, and as approved by MPEP. App. 64-65

The examiner stated: "Further, it is well established that changes in apparatus dimensions are within the level of ordinary skill in the art."

As an authority, among others, the examiner cited *Gardner v. TEC Systems, Inc.* 725 F.2d 1338 (Fed. Cir. 1984), *cert. denied,* 469 U.S. 830 (1984). MPEP 2144.04, Section IV, A.

In *Gardner*, the court did not give any patentable weight to a claimed "formula" limitation, such as:

> "[T]he product of the width of the plate and the spacing of the plate from the web being less than twenty times the nozzle slot width."

As in this case, in *Gardner* the claimed apparatus and the prior art apparatus functioned in the same manner, and the court concurred with the trial court:

> "[T]he dimensional limitations of claim 1 are no more than 'window dressing,' to use our own term."

Pal made the case "pass through," i.e. "no IPED," finding examiner's rationale reasonable and approved by MPEP, and the court precedents, particularly in the first office action, and in the absence of any showing of the criticality of applicant's self-imposed formula limitations.

Upon *re-review* of Pal's "pass-through" status, Dudash decided that the examiner's obviousness rejection of claims 5-10 was defective. App. 70

She composed herself and sent an IPED, but did not prevail at TC1700.

The examining group continued to reject same claims 5-10, and repeated verbatim the same statement, including the January 16, 2007 verbatim rejection. App. 66-67.

Administrative judge entered the January 16, 2007 rejection as Appellant's Hearing Exhibit No. 2. App. 68-69.

Board's Final Decision: Pal committed an error by calling the examiner's obviousness rejection pass through (even though agency adopted Pal's view, and rejected Dudash's position). App. 70

Board's Final Decision was not in Accordance with the Law:

Dudash did not accept examiner's adoption of this court's rationale in *Gardner v. TEC Systems, Inc.* 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied,* 469 U.S. 830 (1984). She went against agency's MPEP 2144.04, Section IV, A.

In *Gardner*, as in this case, the claims contained dimensional (formula) limitations. the court observed: "the dimensional limitations of claim 1 are no more than 'window dressing,' to use our own term." *Id.* 220 USPQ 777, 784.

C
10/724,596
App. 48-54

Agency counsel did not present any rebuttal to Pal's arguments with respect to patentability.

Background: The examiner rejected new claims 57 and 65 under 35 U.S.C. §112, 1st paragraph, description requirement, for lack of support in the specification for the phrase "one of the terminals is formed from aluminum." App. 49

Pal called an examiner IPED error, since there was support for the later claimed subject matter, since the specification did disclose: "Terminals 3 and 4 are aluminum." App. 50

The applicant had "possession" of later claimed subject matter as of the filing date of the application. Dudash initially agreed: "I agree with you that there is support for 'terminals formed from aluminum.'" App. 50

Pal followed the precedents of this court. *In re Wilder,* 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983) (The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter).

Board's Final Decision: Pal made an error. In its legal analysis of the claims, the agency stated in the Notice of Proposed Removal:

> "However, the limitations at issue in claims 57 and 65 differ from the disclosure in the cited paragraphs of the publication, which describe **both** "Terminals 3 and 4 are aluminum." Claim 57 and 65 recite "wherein **one** of the terminals is formed from aluminum" (emphasis added). There is no support in the disclosure for the concept that only one of the terminals is formed from aluminum. Thus, the examiner's rejection of claims 57 and 65 was proper. (bold emphasis original)." App. 51

Dudash testified that the claims left "wide open the other terminal could be something else." "imply one terminal could be formed from something else." App. 54.

Dudash raised claim construction (indefiniteness) issues: "The claims now imply one terminal could be formed from something else...it is unclear that the claims at issue really further limit the independent claims...if you look at claims 58 and 66...what the examiner was thinking." App. 50-51

Board's final decision was not in accordance with the Law:

Pal was reviewing examiner's rejection under 35 U.S.C. §112, 1st paragraph, description requirement, for support, or lack thereof, in the original disclosure, for the later claimed subject matter. App. 49.

Pal was not reviewing whether claims 57 and 65 were indefinite or the scope of the claims under 35 U.S.C. §112, 2nd paragraph.

However, Dudash charged the error alleging issues which are considered properly under 35 U.S.C. §112, 2nd paragraph (claim interpretation), and which are, therefore, irrelevant in this case.

Under 35 U.S.C. §112, 1st paragraph, description requirement, one looks for support in the specification only for the later claimed limitation at issue. In *Moba B.V. v. Diamond Automation, Inc.* 66 USPQ2d 1429, 1439 (Fed. Cir. 2003), this court noted:

> "The test for compliance with §112 has always required sufficient information in the original disclosure to show that the inventor possessed the invention at the time of original filing. *See Vas-Cath,* 935 F.2d at 1561...The possession test requires assessment from the viewpoint of one of skill in the art, *Id.* At 1563-64 ('the applicant must ... convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*') (emphasis in original)."

The court had set a precedent in an essentially identical situation.

In *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989) the court reversed PTO board's affirmation of the examiner's "new matter" rejection, and rejected PTO board's new discussion – "whether the *meaning* of the words is clear and whether the specification contains "guidelines as to what they mean" – as an "irrelevant inquiry." The court observed:

> "The board, on the other hand, launched into a discussion of whether the *meaning* of the words is clear and whether the specification contains 'guidelines' as to what they mean. It felt the words were open to 'different interpretation', which goes to the *scope* of the phrase rather than support for it. We deem this to be an irrelevant inquiry." (Emphasis

original) *In re Wright*, 866 F.2d 422, 9 USPQ2d at 1651 (Fed. Cir. 1989)."

The panel decision contradicts the court's precedents:

Agency's/board's allegation of an error over issues under 35 U.S.C. §112, 2nd paragraph was subject to de novo review by the court. *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994).

The claim indefiniteness issues were irrelevant to Pal's finding, since both Dudash and Pal agreed that the applicant had possession of later claimed subject matter. To justify the IPED in examiner's rejection, Pal only had to establish support for the claimed subject matter in the original disclosure.

The court, by adopting board's position in this case, has contradicted its precedent.

REASONS FOR GRANTING THE PETITION

First, the sole determinant in Pal's removal was that Pal failed to meet 25 percent or less error during the PIP. The court decision did not address the issue at all.

Second, (1) the agency alleged three errors only after it made legal determination – on a case-by-case basis – in the Notice of Proposed removal; (2) to justify the errors, Dudash testified on the legal issues at the trial; (3) to counter agency's allegation of errors, Pal testified and submitted Exhibits on the legal issues; (4) agency counsel did not challenge Pal's legal testimony and Exhibits at the trial; (5) Pal filed appeal brief to the court establishing (in addition to the process) that agency's underlying legal determinations were not in accordance with the law; (6) in respondent's brief, the agency counsel did not rebut Pal's legal arguments in the brief; and finally, (7) in first half of the reply brief, Pal re-emphasized that agency's underlying legal determinations in its allegation of at least three errors were not in accordance with the law. Yet, the court decided without reviewing agency's legal determinations, when presented, without deference.

The court has overlooked its established policy when it reviews decisions from an agency:

> "We review the ultimate legal determination of obviousness without deference ... We review factual findings underlying this determination for substantial evidence." *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

Third, the court follows its review policy, as stated above, when it reviews patent applicant's appeals from the decisions from PTO board without deference, when the issues of obviousness and claim construction are the determining factors. Pal's appeal from another board decision deserved equal treatment and due process under the law by the court.

Finally, if the court affirmed the board by concurring with board's underlying legal conclusions to support the errors – "We have reviewed each of those arguments with care" – the court decision represents a radical departure from its precedents in obviousness and claim construction issues.

The petition for a writ of certiorari should be granted.

Respectfully submitted,

Asokkumar Pal, pro se
12235 Galesville Drive
Gaithersburg, MD 20878
Phone: 301 947-0535

February 14, 2009

APPENDIX A
The December 8, 2008 Decision of the U.S. Court of Appeals for the Federal Circuit

NOTE: This disposition is nonprecedential

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2008-3213

ASOKKUMAR PAL,
Petitioner
v.
DEPARTMENT OF COMMERCE,
Respondent

Asokkumar Pal, of Gaithersburg, Maryland, pro se.

Michael N. O'Connell, Trial Attorney, Commercial Litigation Branch, Civil Division, United States Department of Justice, of Washington, DC, for respondent. With him on the brief were Gregory G. Katsas, Assistant Attorney General, Jeane E. Davidson, Director, and Kirk T. Manhardt, Assistant Director.

Appealed from: Merit Systems Protection Board

NOTE: This disposition is nonprecedential

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2008-3213

ASOKKUMAR PAL,
Petitioner
v.
DEPARTMENT OF COMMERCE,
Respondent

Petition for review of the Merit Systems Protection Board in
DC0432070158-1-2

DECIDED: December 8, 2008

Before LOURIE, CLEVENGER and LINN, Circuit Judges
CLEVENGER, Circuit Judge

Asokkumar Pal ("Pal") seeks review of the final decision of the Merit Systems Protection Board ("Board") sustaining his removal from the position of patent examiner, review quality assurance specialist. Pal v. Dep't of Commerce, No. DC0432070158-1-2 (Feb. 6, 2008). We affirm.

I

The key component of Pal's job, for purposes of this appeal, consisted of reviewing the quality of patent examination work products generated by patent examiners, who, like Pal, work in the United States Patent and Trademark Office ("agency") within the Department of Commerce. This component of Pal's work involved his close review of the actions of patent examiners who regularly reject or accept claims asserted by patent applicants. After review by Pal, he was expected to conclude either that a particular examiner had correctly decided the issues before him, or had made errors in deciding the issues before him.

The agency regularly conducts performance appraisals of the work of its employees. As part of the appraisal of Pal's work during fiscal 2005 and 2006, the agency assessed the review work done by Pal under the critical element "Quality Monitoring." The purpose of reviewing Pal's work under this particular critical element was to determine whether he had correctly judged the work of the particular examiners. In other words, Pal's job was to grade the work of particular examiners, and the performance appraisal of Pal's work graded whether Pal's work was correct or contained error.

On December 8, 2005, Pal's second-line supervisor, Paula Hutzell ("Hutzell") gave Pal a written warning that his performance for fiscal year 2005 was unacceptable in two critical elements, "Quality Monitoring" and training. As a result of this unsatisfactory rating, the agency placed Pal in a performance improvement period ("PIP"), which would take place from December 11, 2005 to March 18, 2006. The object of the PIP was to give Pal the opportunity to perform at a level above "Unacceptable." Pal understood that to avoid an "Unacceptable" grade for his work during the PIP, he could not have an error rate greater than 25 percent.

In order to grade an employee's performance during a PIP, the agency practice at the time was to grade the work done during the entire PIP period by taking a random sample of work done during the PIP on individual cases of decisions by particular examiners. During the PIP period, Pal completed review of 139 cases, representing decisions made by examiners on claims made by patent applicants. By random selection, 16 of Pal's reviews were selected for testing. Each of the cases in which Pal had found fault with an examiner was reviewed, and a sample of cases in which he found no fault was identified by simply picking cases by pointing to the files. Diana Dudash ("Dudash"), Pal's first-line supervisor, and a colleague, Anthony Caputa ("Caputa") reviewed the 16 randomly selected cases. They determined that Pal committed six errors in the 16 cases, yielding an unacceptable error rate of 37.5 percent.

If action was to be taken against Pal for failure of the PIP, the task of proposing official fall to Hutzell, Pal's second-line supervisor. Dudash provided Hutzell with a summary of work she had graded in the random sample. Hutzell made an independent review of that work and agreed with Dudash's assessment. Hutzell also reviewed the assessment by Caputa that Pal had committed six errors, as well as the assessment of David Lacey, who also reached the same conclusion. Hutzell proposed that Pal be removed from his position because he failed the PIP.

Margaret A. Focarino ("Focarino"), Deputy Commissioner for Patent Operations, was the deciding official for Pal's case. Focarino reviewed Hutzell's detailed proposal of removal, as well as Pal's written and oral replies. Focarino asked Steven Griffin ("Griffin"), a Supervisory Patent Examiner, to review in detail the six identified errors. Griffin did so, and concluded that the assignment of error was reasonable.

On November 2, 2006, Focarino acted on Hutzell's recommendation. Although she concluded that Pal had improved his performance on the critical element of training, she decided that Pal's performance under the critical element of "Quality Monitoring" was unacceptable. She therefore notified Pal that effective November 3, 2006, he would be removed.

II

Pal appealed his removal to the Board. The administrative judge ("AJ") assigned to the appeal conducted a hearing, at which Pal was represented by counsel. After hearing the evidence, the AJ concluded that the PIP had been properly conducted and that substantial evidence supported the determination that Pal's performance during the PIP had been unacceptable due to the error rate assigned to the random sample of his work. The AJ's decision upholding the agency's removal action is dated July 27, 2007. Pal sought review of the AJ's decision by the full Board, which denied his petition on February 6, 2008, thus making the AJ's decision the final decision of the Board. Pal then timely sought review in this court.

III

We must affirm the final decision of the Board unless we determine that it is arbitrary, capricious, an abuse of discretion or otherwise not in accordance with law. 5 U.S.C. §7703(c). Facts found by the Board must be supported by substantial evidence.

Id. Substantial evidence is "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Brewer v. U.S. Postal Serv., 647 F.2d. 1093, 1096 (Ct. Cl. 1981) (quoting Consolidated Edison Co. v. Nat'l Labor Relations Bd. 305 U.S. 197, 229 (1938)). This is a highly deferential standard of review: if the Board rests its decision on evidence that could lead a reasonable mind to reach the conclusion reached by the Board, we must accept the Board's decision.

On appeal to this court, Pal mounts essentially the same arguments he raised unsuccessfully before the Board. He contests the PIP process itself, by alleging fatal flaw in the process because only a sample of his work was graded, and further that the method of selecting the sample was scientifically inadequate. The Board rejected Pal's challenge to the process because there is no requirement that the agency must use any particular method for picking which work performed in a PIP will be subject to test. We agree with the Board, and we see nothing unfair or unlawful in the way the agency selected which of Pal's work during the PIP period would be tested.

As part of his challenge to the overall PIP process, Pal also contends that the deciding official (Focarino) should not have been allowed to decide his fate, because she admitted a lack of background in the technology Pal was working with. Pal assigns reversible errors to that fact that Focarino relied on Griffin, who possessed the requisite science background. Focarino testified that she reviewed the proposed removal letter and Pal's oral and written replies. She candidly admitted that she relied on Griffin. Pal points to no law that prevents a deciding official from seeking advice of someone more familiar with the science at issue. We see no error where a deciding official seeks assistance to understand the matter at hand.

Pal also contends that those who graded his work did not understand, and indeed misapplied, the law he applied when he graded the individual examiners. In other words, Pal asserts that his judges were inadequate to the task, since they made errors in judging Pal's work. The substantial evidence standard of review stands in the way of Pal's criticism of his judges.

Dudash provided a detailed explanation of each of the six errors found in the 16 cases selected for grading. Dudash testified at length on the reasoning for her grade of error in the six instances, and others named above also testified that they were in agreement with Dudash. The Board found the testimony of Dudash and the others credible and sufficient for a reasonable mind to conclude that six errors had been committed.

Pal has provided the court with extensive briefs that present further arguments that challenge the PIP process itself and the judgments reached by those who judged his work and finally ordered his removal. We have reviewed each of those arguments with care. Pal's arguments present no reversible error. Substantial evidence shows that the process was fair and that on the record as a whole, a reasonable mind could reach the same conclusion as reached by the Board.

The Board expressed its sympathy for Pal as follows:

> [I]t is extremely unfortunate that the agency could not have found another position for the Appellant, who seems to have many talents and

> has been a successful Federal employee for most of his lengthy career.

The Board, however, is without power to mitigate Pal's removal. The law is clear that when an employee fails a PIP, the agency has the sole discretion to decide whether to remove or demote the employee. See Lisiecki v. Merit Sys. Prot. Bd.. 769 F.2d 1558, 1566 (Fed. Cir. 1985). Like the Board, we too are powerless to mitigate Pal's removal.

Because the Board's final decision is supported by substantial evidence and not contrary to law, we must affirm.

COST

No costs.

APPENDIX B
The January 6, 2009 Denial of Petition for Panel Rehearing

Note: This order is nonprecedential

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

Before Lourie, Circuit Judge, Clevenger, Circuit Judge, and Linn, Circuit Judge

A petition for rehearing having been filed by the Petitioner,

UPON CONSIDERATION THEREOF, it is ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on January 29, 2009.

FOR THE COURT,

s/ Jan Horbaly
Clerk

Dated: 01/06/2009
cc: Asokkumar Pal
Michael N. O'Connell
PAL V COMMERCE 20-08-3213
(MSPB – DC0432070158-1-2)

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
JAN 06 2009
JAN HORBALY, CLERK

APPENDIX C

The January 26, 2009 Denial of Motion and Petition for Rehearing en banc

NOTE: This order is nonprecedential

United States Court of Appeals for the Federal Circuit
2008-3213
ASOKKUMAR PAL, Petitioner
v.
DEPARTMENT OF COMMERCE, Respondent

Petition for review of the Merit Systems Protection Board in DC0432070158-1-2

ON MOTION

Before LOURIE, CLEVENGER, and LINN, Circuit Judges.

ORDER

Asokkumar Pal moves for leave to file a petition for rehearing en banc.
IT IS ORDERED THAT:

The motion is denied.

FOR THE COURT

JAN 26 2009 s/ Jan Horbaly
Date Clerk

cc: Asokkumar Pal
Michael N. O'Connell, Esq.

APPENDIX D

PETITION FOR PANEL REHEARING

NOTE: Page reference in **bold**, such as **A100**, refers to page 100 in the Petitioner's Appendix; page reference in **bold**, such as **SA100**, refers to page 100 in Respondent's Supplemental Appendix

2008-3213

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Asokkumar Pal v. Department of Commerce

Petition for Review of the Merit Systems
Protection Board's
Final Decision in DC-0432-07-0158-1-2

PETITION FOR PANEL REHEARING

Petitioner Asokkumar Pal (Pal) files this petition for rehearing stating with particularity each point of law or fact that Pal believes the Federal Circuit (Court) has overlooked or misapprehended, and argues in support of the petition.

Pal believes that the Court overlooked or misapprehended that Pal – in his briefs, particularly the reply brief (p.2) – identified, and elaborately argued Agency's sole reason for removal of Pal by Margaret Focarino: Pal made six errors/mistakes in 16 cases during the performance improvement period (PIP).

The removal letter clearly identified *one and only* reason: Ms. Focarino removed Pal because Pal had 6 errors in 16 cases reviewed, or error rate more than 25 percent; the Board, by affirming, adopted this conclusion as its final decision.

Facts – six errors involving separate and distinct issues – found by the Board must be supported by relevant substantial evidence. The Court would not affirm the final decision of the Board, if at least two errors, individually, were not supported by substantial evidence, or if the final decision was arbitrary, capricious, an abuse of discretion, otherwise not in accordance with law. Pal argued that Board's final decision with respect to three cases was not in accordance with law.

Pal extensively addressed and argued the issue in 50% of his principal brief, (pp. 9-11, 22, 31-53, and concluded at p. 56, 57). Pal discussed the set goal (25%) as unrealistic, unachievable, and not identically enforced for other reviewers (Section IV), two arbitrary errors for not checking a box (Section V), and, more significantly, four errors where the question of law was the issue (Section VI).

Agency officials never responded to Pal's internal appeals. At the hearing, patentability expert, and in his brief, agency counsel made no attempt to refute Pal's arguments (Section VI), on a case-by-case basis. That the agency brief made no attempt to refute Pal's argument, was more reason to reverse the final decision of the Board. Pal testified exclusively on the propriety of six errors, and agency counsel and technical expert did not challenge Pal's testimony at hearing.

Accordingly, in Pal's November 10, 2008 reply, in view of the Court's instruction – "to file memorandum presenting...answers to points in an opposing brief" – Pal was prohibited to discuss, and chose not to raise, "four errors."

Pal again emphasized Agency's "sole reason" (p. 2) for removal, standard of review (pp. 3-4), and four cases involving question of law (pp. 4-9) in the first half of his reply brief (pp. 2-14), and discussed six errors on a case-by-case basis.

Pal believes that since he appealed to the Court, and respectfully requested judicial review on all issues, the Court at least consider particularly his arguments with respect to the sole reason – three errors – in the removal letter.

Court's December 8, 2008 decision did not address the issues...

Pal believes the Court has overlooked that three cases involved Board's ultimate legal determinations. The Court reviews ultimate legal determinations without deference. Since Board's legal determinations – Facts – are not in accordance with law, three alleged errors are not supported by substantial evidence.

The Board affirmed six errors, and thereby adopting Agency's underlying findings in all six cases, and in the three cases, additionally, adopting the ultimate legal determinations as its own. In *Zurko*, this Court said:

> "We (Federal Circuit] review the ultimate legal determination of obviousness without deference...We review factual findings underlying this determination for substantial evidence."

Pal believes that in three cases (10/724,596, 10/640,364, and 10/612,149 – discussed later), he was entitled to have judicial review of Board's ultimate legal determination without deference. Pal believes that the Court overlooked.

The Court overlooked that Pal made propriety of the Board's ultimate legal determinations in the three cases as the central issue: They were not in accordance with the law; evidence not in accordance with law is not substantial evidence.

At the hearing, Pal testified exclusively on the patentability issues on a case-by-case basis. **A231-A250**. Agency counsel Lisa Belasco and patentability expert Wanda Walker did not dispute or cross-examine Pal's testimony.

In the brief, agency counsel did not present any rebuttal on a case-by-case basis; counsel simply argued that five patent professionals "reviewed and concurred with the errors [as Dudash found]." Agency counsel provided no evidence, or authorities. Her positions were not always in accordance with the law.

Pal repeated and emphasized legal issues in the reply brief (pp. 2-14).

Review process, and set goal (25%), unrealistic and not uniformly enforced, were serious issues; but, it would be unfortunate not to have any judicial review of Pal's principal arguments: At least three errors were not in accordance with law.

POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE COURT

I. In the brief at 42-53 and in the reply brief at 4-9, Pal established that the board's ultimate legal determinations in three cases were not in accordance with the law. Pal respectfully believes that the

Court overlooked the requirement of review of the ultimate legal determinations without deference.

II. Board's final decision regarding two errors for not checking a box in a form was not supported by substantial evidence: Ms. Dudash arbitrarily imposed her requirement without authorization, and against the Agency policy. All officials testified against and disapproved her unilateral action. Court overlooked.

III. The Court misapprehended the fact that when Pal was placed in the PIP requiring him not to make errors in excess of 25%, the Agency knew that the standard was unrealistic. Section IV in the brief showed that majority of reviewers had error rates higher than 25% and still were rated outstanding or commendable a month ago; Pal was rated unacceptable and removed.

IV. The Court overlooked the fact that the Agency effectively shortened the improvement period. Agency stopped reviewing Pal's work products during the last two months of the PIP, and violated the Agency rule by not having a required mid-point "Progress Review.

ARGUMENT

I

A review under the substantial evidence standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the board's final decision. The Court recognized that the Supreme Court observed that Federal Circuit judges "will examine [board fact] findings through the lens of patent-related experience...for the Federal Circuit is a specialized Court." *In re Zurko*, 258 F.3d 1379, 59 USPQ2d

1693, at 1696 (Fed. Cir. 2001), *on remand from Dickinson v. Zurko,* 527 U.S. 150 (1999). Evidence that is not in accordance with the law cannot be substantial evidence.

Reasonable minds would choose Pal's position (b) in preference to agency position (a) Agency counsel stated (brief at p. 17):

> "Mr. Pal failed to address the agency's contentions in a direct manner that would have allowed the administrative judge to evaluate his arguments."

Pal supplemented his testimony by summarizing the law and arguments as Exhibits (**A340-41**, **A369**, **A415**), and provided MPEP Chapter 2100 as Pal's Hearing Exhibit 3, admitted by the judge. **A250** (Sections included in Appendix)

(a) Agency position in view of Ms. Dudash's testimony, her conclusions made without citing a precedent, and the absence of any counter-arguments on a case-by-case basis in the agency brief, versus

(b) Pal's opposing positions in testimony and briefs, based on the law, legal conclusions supported by this court's precedents, and the summaries (law and arguments) in Pal's hearing Exhibits (**A340-41** **A369**, **A415**) citing MPEP sections.

10/724,596

(Agency brief: None; Pal's brief at 43-45 reply
Brief at 8-9, Exhibit **A340-41**)

Dudash testimony, **SA117-119** Pal's testimony,
A241-243

Background: The examiner rejected new claims 57 and 65 under 35 U.S.C. §112, 1st paragraph, description requirement, for lack of support in the specification for the phrase "one of the terminals is formed from aluminum." Pal called an examiner error; the specification disclosed:" Terminals...are aluminum;" applicant had "possession." Ms. Dudash initially agreed (**A339**), and even testified: "claimed terminals to be aluminum." **SA118**

Board's Final Decision: Pal made an error since, as Ms. Dudash testified, the claims left "wide open the other terminal could be something else." **SA119**, "imply one terminal could be formed from something else," **A339**, or whether "the claims at issue really further limit the independent claims." **A339**

Board's Final Decision was not in Accordance with the Law: 35 U.S.C. §112, 2nd paragraph (claim interpretation) was the proper statute for such issues, and they are irrelevant in this case. **A338** Under 35 U.S.C. §112, 1st paragraph, description requirement, one looks for support in the specification only for the claim limitation at issue.

In *In re Wright*, 866 F.2d 422 (Fed. Cir. 1989) this Court reversed PTO board's affirmation of the examiner's "new matter" rejection, rejected PTO board's new discussion – "whether the *meaning* of the words is clear and whether the specification contains "guidelines as to what they mean" – as an "irrelevant inquiry." The Court observed that such an inquiry "goes to the *scope* of the phrase rather than support for it." Pal's brief at 45.

Board's Final Decision Not Supported by Substantial Evidence: Pal showed the necessary support, and Agency agreed that applicant had "possession"– the only requirement under 35 U.S.C. §112, 1st paragraph, description requirement; *Wright* makes underlying findings in the final decision irrelevant and unlawful.

10/640,364
(Agency brief p. 17; Pal's brief at 45-47, reply Brief at 4-5, Exhibit **A369**)
Dudash testimony, **SA114-117** Pal testimony, **A239-241**

Background: The examiner rejected the claims under 35 U.S.C. §103 as obvious over Rohrbach in view of Drozd and Graiff. The examiner noted, and Dudash acknowledged, that Rohrbach and Drozd did not teach the claim limitations – ion exchange resin adsorbent, wherein the additive is removably bound to the ion exchange resin by a chemical interaction, and (later) partially removed from the ion exchange resin by means of a chemical interaction.

The examiner rationalized, and Ms. Dudash agreed that it was proper, that, even though Rohrbach and Drozd did not disclose ion-exchange resin, they disclosed similar material of "high surface area and surface modified sorbents," and "mixture of adsorbents and thermoplastic resins," and that it would have been obvious to replace the adsorbents in Rohrbach with the ion-exchange resin in Graiff. **A356** Graiff taught the opposite process (ion exchange resin to remove impurities) while the Rohrbach and Drozd processes taught addition of components into the fuel composition, the same objective as in applicant's process.

Board's Final Decision: Pal made an error by calling the examiner's rejection unacceptable (IPED) in accordance with 35 U.S.C. §103.

Board's Final Decision was not in Accordance with the Law: References did not teach the claim limitations (except Graiff taught ion exchange resin). Examiner made an impermissible combination of conflicting references. Examiner failed to treat Graiff teachings *as a whole*. The rationalization was not based on evidence in the record, and lacked substantial evidence. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Finally, TC1700 withdrew the rejection when the applicant rebutted the same way as Pal did, reversing Agency's original position.

Board's Final Decision Not Supported by Substantial Evidence: Examiner argued, and Ms. Dudash adopted the notion, that "one of ordinary skill...[would] have considered the additive releasing sorbents of Rohrbach et al to encompass 'ion exchange resin.'" **A356** The position was not in accordance with *In re Zurko*.

Rohrbach and Drozd add additives *to* a fuel, and did not teach ion exchange resin, or the chemical interactions, while Graiff removes impurities *from* the fuel by ion exchange resin; the combination of the contradictory references was impermissible under 35 U.S.C. §103. Ms. Dudash testified: "They [references] fit together very nicely into a well-explained art rejection...all the pieces were there and there were suggestions to put the process together to teach the invention." **SA116-17** Her testimony was not credible, contrary to agency brief at p. 17.

10/612,149

(Agency brief: No Discussion; Pal's brief at 49-52, reply Brief at 6, Exhibit **A415**)

Dudash testimony, **SA108-111** Pal testimony, **A234-237** and **A248**

Background: Pal found no fault in examiner's action, and made the case a "pass-through." Upon *re-review* of Pal's "pass-through" status, Ms. Dudash decided that the examiner's obviousness rejection of claims 5-10 was defective. She composed herself and sent an IPED, but did not prevail at TC1700. **A412**

Board's Final Decision: Pal called pass through (Ms. Dudash initiated, composed, and sent IPED, but failed at TC1700; Agency adopted Pal's view)

Board's Final Decision was not in Accordance with the Law: Ms. Dudash did not accept examiner's adoption of this Court's rationale in *Gardner v. TEC Systems, Inc*. 725 F.2d 1338 (Fed. Cir. 1984), 220 USPQ 777, *cert. denied,* 469 U.S. 830 (1984). She went against Agency's MPEP policy.

MPEP 2144.04, Section IV, A suggested the examiners to use the *Gardner* rationale in similar fact-situations in the absence of shown criticality. In *Gardner*, as in this case, the claims contained dimensional (formula) limitations; the Court observed: "the dimensional limitations of claim 1 are no more than 'window dressing,' to use our own term." *Id.* 220 USPQ 779, 784.

Board's Final Decision Not Supported by Substantial Evidence: It was not Pal's action that TC1700 rejected – if fact, TC actually adopted the same status as Pal did; Ms. Dudash proposed, composed, and tried, but failed at TC1700 – Pal had nothing to do with it. It was unjust to charge an error to Pal for a position he identified to be against the Agency policy, and was proven right. **A414**

TC1700 rejected her proposed IPED, and adopted Pal's "no IPED" position. In defiance, the examiner repeated the same rejection (December 2005, that was under Pal's review, **A408-409**) of the same claims *verbatim* three more times, including the last rejection (March 2007, **A423-424** introduced into record by the Administrative Judge as Appellant's Hearing Exhibit 2. **A248**)

Conclusion on the three cases

Since the Board "facts" – agency's legal determinations adopted by the Board as its own final decision – involved law, the Court makes the ultimate legal determination without deference. Counsel argued (p. 16): the Court should accept any position agreed upon by 5 professionals and Ms. Dudash as substantial evidence, even if it was legally wrong. On the contrary, the Court should reverse Board's final decision as being not in accordance with the law. Reasonable minds will not accept a conclusion not in accordance with the law as substantial evidence.

•••

CONCLUSION

Early on, Pal clearly identified that, in order to overcome the final decision of the Board, he had to establish that he actually had an error rate 25% or less. Ms. Focarino clearly identified the sole criteria in the removal letter and later, at hearing reconfirmed. See reply brief at 2.

Accordingly, Pal presented the briefs emphasizing this ultimate goal. See brief at pp. 9, 22, 52-53 and last paragraph at p. 57. See reply brief Contents (p. 1-2), first entry, and reply brief at pp. 2-14. Other issues were discussed, e.g., review process, unrealistic goal, and most important, lack of discretion in enforcing the same error rate schedule to other similarly positioned reviewers.

Pal appealed to higher management several times, but received no response. It will be unfortunate if Pal fails to receive judicial review by the Federal Circuit, whose decisions in patentability Pal follows and admires for the logic and fairness.

10/724,596: Agency agreed with Pal that applicant had possession – all Pal had to show. Still, the agency charged error by bringing in issues (indefiniteness, dependency of claims) outside the scope of the "new matter" rejection. **A340-41**

10/640,364: References did not teach claim limitations; this Court, *In re Zurko,* specifically ruled against agency's rationalization, and the combination of contradicting references was impermissible, 35 U.S.C. §103. Moreover, TC1700, examining unit which makes the final determination regarding the patentability of claims, clearly disagreed with the OPQA position, and allowed the claims. **A369**.

10/612,149: Pal adopted "pass through" (no fault) status. Agency accepted the same status. Supervisor proposed, composed IPED herself, sent to TC1700, but failed to prevail. TC1700 repeated the same rejection *verbatim* several more times. Pal was a bystander; yet, he was charged with error for the initiative his supervisor took, but failed to prevail. **A415**

Pal should not be charged with these three errors. Pal did meet the *only* criterion set by the Agency for the improvement period – 25% or less error. In addition, Pal respectfully argues that the final decision of the board, in many respects, was arbitrary, an abuse of discretion, or otherwise not in accordance with law.

The Court is urged to rehear the appeal, and reverse Board's final decision.

Respectfully submitted,

s/ Asokkumar Pal

December 18, 2008
Copy: Michael N. O'Connell, Esq.

APPENDIX E

EXCERPTS FROM PAL'S PRINCIPAL BRIEF
True copy of Arguments Related to the Patentability Issues (pp. 42-53)

NOTE: Page numbers in **bold** refer to pages in the Appendix filed with the Petitioner's principal brief

VI. REMAINING FOUR ALLEGED MISTAKES WERE NOT MISTAKES UNDER THE LAW; IN ITS ALLEGATION OF THESE MISTAKES BASED ON THE PATENTABILITY ISSUES, THE AGENCY DID NOT FOLLOW THE PATENT STATUTES, PROCEDURES IN THE MPEP, AND/OR THE PRECEDENTS OF THIS COURT.

It was more convenient – without accountability – for Ms. Dudash to charge mistakes to Mr. Pal in his IPED work products, where he raised an IPED, than in a pass through case, where there was no issue to contradict.

She could charge a mistake to Mr. Pal in IPED cases by disagreeing with him, and by deleting the IPED from record, even if she was legally and/or technically wrong. She did not have to defend her wrong position anywhere in the Agency. She charged three mistakes to Mr. Pal in IPED cases where Mr. Pal raised an IPED; she declared disagreement with him and deleted the IPEDs.

Conversely, to charge a mistake to Mr. Pal in his pass through cases with no pending issue, she had to come up with a legally and technologically valid IPED in the patent examiner action, and defend it at the TC director's office on record. If TC finally refused to incorporate her proposed changes in that action, she could not charge a mistake to Mr. Pal. In the fourth case, made pass through by Mr. Pal, she raised an IPED, which the TC repeatedly ignored. She still charged the mistake to Mr. Pal, even though the IPED was not his idea.

10/724,596 (Appellant proposed an IPED, Ms. Dudash withdrew IPED)

1. The Agency supported examiner's "new matter" rejection of the new claims under 35 U.S.C. §112, first paragraph, which Mr. Pal called an IPED since the applicant had possession (support) of the claimed subject matter in the original disclosure; in charging the mistake to Mr. Pal, the Agency violated patent law and this court's precedents.

The phrase "an adjacent one of the terminals" in independent claims 42 and 49 was further limited in corresponding new dependent claims 57 and 65: "wherein one of the terminals is formed from aluminum" **321-23**. The examiner rejected new claims 57 and 65 (among others) under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement ("new matter" rejection). **324**.

Applicant had support in the specification: "Terminals 3 and 4 are aluminum." **332** (¶0075). Mr. Pal declared an IPED. **336-37**. However, Ms. Dudash disagreed, deleted the IPED, and charged a mistake to Mr. Pal. **338-39**.

Ms. Dudash initially agreed: "I agree with you that there is support for 'terminals formed from aluminum....'" **339**. She still maintained that the examiner's rejection was not in violation of 35 U.S.C. §112, first paragraph, description requirement on the ground: "The claims now imply one terminal could be formed from something else." **339**.

The inventor had possession of the claimed subject matter as of the filing date of the specification. Mr. Pal presented arguments to support his proposed IPED, but Ms. Dudash would not even respond to such arguments. **338**. Instead, Ms. Dudash would arbitrate: "I am unwilling to send this ... as an IPED." **338**

During the hearing, Mr. Pal testified that the Agency applied MPEP standards and this court's precedent inappropriately. **340-41** Appellant's Exhibit M. **241-43** (Transcript at 419-21; Pal). The Administrative Judge did not address this issue in his Initial Decision or in the Erratum.

Ms. Dudash looked for support in the specification for something that was not in the claims at issue; she speculated what the claims might imply. In a similar fact-situation, this court reversed the PTO board's affirmation of the examiner's "new matter" rejection:

> "The board ...launched into a discussion of whether the *meaning* of the words is clear and whether the specification contains 'guidelines' as to what they mean. It felt the words were open to 'different interpretation', which goes to the *scope* of the phrase rather than support for it. We deem this to be an irrelevant inquiry." (Emphasis original) In re Wright, 866 F.2d 422 (Fed. Cir. 1989).

An objective standard for determining compliance with the written description requirement is whether the description clearly allows persons of ordinary skill in the art to recognize that he or she invented what is claimed. MPEP 2163(b). 333. In re Gostelli, 872 F.2d 1008, 1012 (Fed. Cir. 1989); Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

The Administrative Judge did not address the issue that the Agency did not follow the patentability standards established by this court with respect to "new matter" rejection under 35 U.S.C. §112, 1st paragraph.

10/640,364 (Appellant proposed an IPED, Ms. Dudash withdrew IPED)

2. The Agency supported examiner's obviousness rejection under 35 U.S.C. §103(a), even though the primary references failed to teach applicant's claim limitations; in addition, the Agency supported examiner's combination of references, even though the secondary prior art process destroys the objective of the primary prior art process, and teaches a process that contradicts applicant's claimed process. Mr. Pal called it an IPED; Ms. Dudash disagreed. Agency's position violated patent law and precedents set by this court.

The applicant introduced several key limitations into the claims by amendments (e.g. claim 1). **351**. The examiner rejected the claims under 35 U.S.C. §103(a) as being obvious over Rohrbach (et al.) in view of Drozd (et al.) and Graiff (et al.). **355-58**

As observed by Mr. Pal, Rohrbach failed to teach any of the key limitations – ion-exchange resin adsorbent and chemical interactions with the ion-exchange resin in the both the initial binding and later removal processes for the additive. **360**. Also, the examiner applied an impermissible combination of the conflicting references. **360, 362**. Mr. Pal proposed an IPED. **360**

Ms. Dudash considered the examiner rejection to have met 35 U.S.C. §103(a), deleted Mr. Pal's proposed IPED – "I cannot send this back" – and charged a mistake to Mr. Pal. **361** Mr. Pal asked her to show where Rohrbach taught ion-exchange resins, and where Graiff taught chemical interaction being involved in their respective processes. **363**. She did not respond. **362-63**

The examiner failed to establish a *prima facie* case of obviousness. In re Royka, 490 F.2d 981 (CCPA 1974); In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970). By accepting the examiner rejection, the Agency also approved a legally impermissible combination of the references in violation of 35 U.S.C. §103(a).

Graiff used ion-exchange resins to remove impurities away from a fuel composition. **365-68** (Abstract, Claim 1). In contrast, Rohrbach and Drozd intended to add beneficial additives into the fuel composition.

Ms. Dudash's position was in violation of several MPEP Sections. **369** (Appellant's Exhibit L); **239-41** (Transcript at 417-419; Pal).

It is impermissible to pick and choose from one reference only so much of it as will support a given position. In re Hedges, 783 F.2d 1038 (Fed. Cir. 1986); In re Gurley, 27 F.3d 551 (Fed. Cir. 1994).

The inventor independently rebutted and established the same deficiencies in examiner's rejection as Mr. Pal had done when he proposed the IPED. The inventor argued that Rohrbach or Drozd did not teach ion-exchange resins, and did not teach chemical interactions involved in both the binding and releasing processes for the additives. **371-72.** The inventor also argued that Graiff used ion-exchange resins for the opposite process. **374**

TC would have agreed with Mr. Pal, had they seen his proposed IPED, since they agreed with inventor's rebuttal on the same grounds, withdrew the pending rejection, and allowed the claims.

In alleging a mistake to Mr. Pal in this case, the Agency did not follow the patent statute and the precedents of this court. The Administrative Judge did not address the issue in the Initial Decision.

...

10/612,149 (Appellant made the case pass through)
(Ms. Dudash proposed an IPED; TC disregarded the IPED)

4. The examiner followed this court's precedent in Gardner v. TEC Systems, Inc. 725 F.2d 1338 (Fed. Cir. 1984), cert. denied, 469 U.S. 830 (1984), and properly applied this court's rationale in a rejection under very similar fact-situation; Appellant made the case a pass through. Ms. Dudash proposed an IPED of her own. The examining group refused to accept Ms. Dudash's position, and repeated the same rejection of the same claims verbatim several times in subsequent actions. Agency still held Appellant responsible for a mistake even though the IPED was Ms. Dudash's idea and the examining group rejected her idea.

Mr. Pal found no error in the examiner action, and made it a pass through; Upon review, Ms. Dudash raised an IPED and sent the IPED to TC, but TC repeatedly refused to incorporate her proposed changes.

Claims 5-10 contain formula limitations, such as the ratio of diameter of the shower head to the inner diameter of the film-forming chamber. **401-02**. The examiner rejected (December 14, 2005) claims 5-10 under 35 U.S.C. §103(a) as being unpatentable over Okase; Wataru. **408-09**.

The examiner had already established that Okase/Wataru taught every element of the claimed apparatus, except the formulas in claims 5-10. **403-408**. The applicant made no effort to establish criticalities of the preferred formula limitations. Mr. Pal found no IPED in the examiner rejection of claims 5-10, based on the rationale in Gardner, and made the case a pass through.

The examiner rationalized that "it is well established that changes in apparatus dimensions are within the level of ordinary skill in the art." **409**. The examiner followed this court's established rationale under similar fact situation, as suggested in the MPEP, 2144.04, Section IV, A, citing Gardner. **409**.

Ms. Dudash proposed, composed, and sent an IPED to TC, and asked the examiner to modify the current rejection of claims 5-10. **411-12**.

Ironically, she continued to ask the examiner to consider MPEP 2144.04, Section IV, A, which recommends Gardner rationale in similar fact situation. **412** The examiner had relied on the same precedent in his rejection. **409**

Mr. Pal argued that the examiner's rejection followed MPEP and this court's precedents. **413-14**. She also charged a mistake to Mr. Pal.

At the hearing, Mr. Pal emphasized that the Agency was wrong. **234-37** (Transcript at 412-15; Pal). **415** (Appellant's Exhibit J). The examiner had already properly followed MPEP 2144.04, Section IV, Subsection A, and this court's rationale, as asked by Ms. Dudash.

In Gardner, this court did not give any patentable weight to a claimed "formula" limitation, such as:

> "[T]he product of the width of the plate and the spacing of the plate from the web being less than twenty times the nozzle slot width."

As in this case, in Gardner the claimed apparatus and the prior art apparatus functioned in the same manner, and this court concurred with the trial court: "[T]he dimensional limitations of claim 1 are no more than 'window dressing,' to use our own term."

There is evidence that TC never agreed and nor incorporated Ms. Dudash's proposed changes. The December 2005 examiner rejection that was under review rejected claims 5-10 as obvious over Okase; Wataru. **408-09**. The examiner refused to amend his rejection in view of Ms. Dudash's proposed IPED in December 2005 rejection. When claims 5-10 were re-filed, the examiner repeated the same rejection of claims 5-10 substantially in the same manner in the March 16, 2007 rejection, again defying Ms. Dudash's proposed IPED. **423-24** (Appellant's Hearing Exhibit Number 2); **248, 249** (Transcript at 435, 438; Administrative Judge's decision).

In the Initial Decision, the Administrative Judge did not consider Mr. Pal's testimony. **234-37** Since Ms. Dudash proposed the IPED, not Mr. Pal, and the examining group rejected her idea, not Mr. Pal's, there is no reason for the Agency to hold Mr. Pal responsible for a mistake that Ms. Dudash made.

Conclusion: *This court should reverse Board's decision, since in charging these four patentability mistakes to Mr. Pal the Agency did not follow patent law and/or this court's precedents, but applied arbitrary standards.*

As Mr. Pal testified at the hearing, the Agency was in violation of Agency's MPEP, patent statutes, this court's precedents, and/or IPED rules in charging all four alleged patentability mistakes to Mr. Pal. **231-46** (Transcript at 409-24; Pal). Had the Agency not applied improper legal standards in at least two cases, Mr. Pal would have met the requirement set in the PIP. With four or fewer mistakes in 16 cases reviewed by the Agency in the PIP, Mr. Pal's mistake rate would have been 25 percent or less, and Mr. Pal would have met the requirement set by the Agency for his performance during the Improvement period. Ms. Focarino removed Mr. Pal solely on the basis of number of mistakes.

APPENDIX F

EXCERPTS FROM RESPONDENT'S BRIEF

True Copy of Agency Counsel's Comments on Legal or Patentability Issues (pp. 1-2, 15-18)

2008-3213

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ASOKKUMAR PAL
Petitioner,
v.
DEPARTMENT OF COMMERCE,
Respondent.

PETITION FOR REVIEW OF THE MERIT
SYSTEMS PROTECTION BOARD
IN DC-0432-07-0158-1-2

BRIEF OF APPELLEE, DEPARTMENT OF COMMERCE

COUNTER STATEMENT OF THE ISSUE

Whether substantial evidence supported the administrative judge's finding that the agency proved that Mr. Pal's performance was deficient during the performance improvement period.

COUNTER STATEMENT OF THE CASE

1. Nature Of The Case

The petitioner, Asokkumar Pal, seeks judicial review of a Merit Systems Protection Board ("MSPB" or "board") decision that became final on February 6, 2008. The Department of Commerce, United States

Patent and Trademark Office (PTO), removed Mr. Pal for a deficiency in his performance.

...

3. The Record Supports The Agency's Conclusion That Mr. Pal Committed Errors

Mr. Pal argues at pages 39 to 54 of his brief that the errors with which he was charged were not actually errors. In this case, the administrative judge was presented with testimony from five patent professionals at the PTO, all of whom reviewed and concurred with the errors charged to Mr. Pal. In particular, Ms. Dudash testified at length concerning Mr. Pal's six errors. SA100-23. The administrative judge found the testimony of these patent professionals to be credible and consistent with the voluminous documentary evidence. PA17-18[1]. Mr. Pal admitted that he made mistakes but also testified that he had not committed the six errors charged. PA16[2]

At pages 39-43[3] of his brief Mr. Pal admits that he made mistakes when he failed to propose IPEDs in two cases and instead deemed them pass throughs. However, Mr. Pal argues that he should not have been charged with errors in these cases because he had identified the issues in the patent examiner's work, even if he failed to propose IPEDs. When asked why she charged Mr. Pal with an error in one of these cases, Ms. Dudash testified that "the heart of his work is making the decision on calling and proposing an error or not an error...." SA106 at lines 16-17. In other words, although some of Mr. Pal's underlying analysis was correct, his ultimate decision not to propose an IPED was incorrect. Considering that Mr. Pal designated these cases as pass throughs, which are reviewed by his supervisor, it was reasonable for the agency to be concerned with such mistakes by Mr. Pal.

---

[1] These pages in administrative judge's decision refer to administrative judge's conclusion, not to the transcripts of actual testimonies of other patent professionals.

[2] This page refers to administrative judge's conclusion, not Mr. Pal's actual testimony. Mr. Pal made no such commitment in writing (in briefs) or in testimony.

[3] THIS PARAGRAPH IS INCLUDED FOR COMPLETENESS AND CONTINUITY. These pages refer to two applications (11/044,913 and 10/891,028) where the issue was whether Pal made mistakes by not checking a box in the X-IPED form, even though the agency substantially agreed with Pal on patentability issues, and ACCEPTED Pal's comments with minor editorial changes, e.g. correcting spelling. Since a dispute between the agency and Pal with respect to a question of law is not involved in these two cases, PAL IS EXCLUDING THESE TWO CASES FROM HIS PETITION FOR WRIT OF CERTIORARI.

Mr. Pal disputes that the remaining four errors with which he was charged were, in fact, errors. Before the board, Mr. Pal failed to address the agency's contentions in a direct manner that would have allowed the administrative judge to evaluate his arguments.

For example, in the notice of proposed removal, the agency explained its rationale in detail with respect to why Mr. Pal committed an error in application number 10/640,364. PA 105-06. During her testimony before the board, Ms. Dudash then explained that this application concerned an extended release for additives in a fuel system." SA115/9-10. She stated that the patent examiner had made an obviousness rejection pursuant to 35 U.S.C. §103. Id. At 17-22. Mr. Pal disagreed with the determination and proposed an error. SA116/16-17. Ms. Dudash disagreed with Mr. Pal. During his testimony (PA239-40), Mr. Pal gave a relatively brief explanation as why he disagreed with Ms. Dudash.

Having found the agency witnesses to be credible and their testimony consistent with the documentary evidence, the administrative judge correctly held that the agency had met its burden of establishing that Mr. Pal's performance was deficient. This determination was particularly correct given the great deference owed to the agency because of the scientific and technical nature of the work at issue. See Greer v. Dep't of Army, 79 M.S.P.R. 477, 485 (1998) (holding that the board normally should give deference to agency assessment of its own personnel needs and standards, particularly where the assessment is of a scientific nature).

...

Respectfully submitted,
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DATED: September 9, 2008

APPENDIX G

EXCERPTS FROM PAL'S REPLY BRIEF

True copy of Arguments Related to the Patentability Issues (pp. 1-12)

NOTE: Page Numbers, such as **A100** in **bold** refer to the Petitioner's Appendix filed with the Principal Brief

Page Numbers, such as **SA100** in **bold** refer to the Respondent's Supplemental Appendix filed with the Respondent's Brief

2008-3213
IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT
Asokkumar Pal v. Department of Commerce
Petition for Review of the Merit Systems
Protection Board's
Final Decision in DC-0432-07-0158-1-2

REPLY BRIEF OF ASOKKUMAR PAL

Petitioner Pal may decide to present an oral argument if Appellee files a reply brief introducing new issues (if entered into record).

DEFINITION

Consistent with Mr. Pal's principal brief, a "mistake," as used in this Reply Brief, is an error by the reviewer, as alleged by the Agency in its review of the work product. An "IPED" (in-process examination deficiency), as used in this Reply Brief, is a patent examiner's error, as alleged by the reviewer – either an improper rejection or an improper allowance of the claims.

Reference to pages, e.g., page 100, in Mr. Pal's principal brief is indicated as "Pal's brief at 100"; reference to page 100 in Appellee's (Agency) brief is indicated as "Agency brief at 100." Reference to page 100 in Mr. Pal's Appendix is indicated as **A100**, while reference to page 100 in Agency's Supplemental Appendix is indicated as **SA100**.

ALLEGED SIX MISTAKES WERE NOT MISTAKES IN ACCORDANCE WITH THE LAW; ON ULTIMATE LEGAL DETERMINATION, THIS COURT WILL FIND THAT TWO OR MORE ALLEGED MISTAKES WERE NOT LEGALLY VALID AND MR. PAL'S ERROR (MISTAKE) RATE WAS AT OR BELOW 25 PERCENT. HE RESPECTFULLY REQUESTS THIS COURT TO REVERSE THE BOARD DECISION.

1. The Agency removed Mr. Pal for the sole reason that he allegedly failed to meet the required percent mistake rate at or below 25 percent during the Performance Improvement Period (PIP).

On November 2, 2006, Agency's deciding official, Margaret Focarino, removed Mr. Pal solely because of the number of his mistakes and number of cases reviewed during the Improvement period (PIP), as alleged by the Agency:

> "While your performance in the critical element *Training* improved, your performance in the critical element *Quality Monitoring* did not. ... During the improvement period, which began December 11, 2005, and ended March 18, 2006, your quality error [mistake] rate was 37.5%. You were required to achieve at least the Marginal level of performance by having an error [mistake] rate of no more than 25%. ...

> "I conclude that your performance was unacceptable in the critical element *Quality Monitoring*, and that removal is the appropriate action under the authority of 5 U.S.C. § 4303" (Emphasis original). **A132**

During the hearing (April 2007), Ms. Focarino testified and reconfirmed her "decision to remove Mr. Pal from his position:"

> "Because the proposed removal was based on an error [mistake] rate that was, I think, in the high 30 percentile and therefore his work was unsatisfactory and ... so I sustained the removal." **SA244** (lines 7-13)

The Agency allegedly reviewed Mr. Pal's 16 work products, and found six mistakes – all completed during the first half of the PIP. Supervisor Diana Dudash reviewed 10 work products having issues because Mr. Pal was required to inform her – eight IPEDs and two with issues that did not rise to be IPEDs, but needed correction. She selected for review six pass through cases from remaining 129 work products by a non-random method – five cases from 2nd biweek and one case from 5th biweek of the 7-biweek Improvement period. The Agency stopped reviewing Mr. Pal's work products completed after January 20, 2006 (nearly two months before the end of PIP). **A280**

This Court, upon ultimate legal determination, will find that Agency's "pencil-to-paper" selection method did not meet board's "substantial evidence" standard, which the MSPB established when the Agency takes an adverse personnel action (demotion, denial of step increase, and definitely removal).

2. Three of the alleged six mistakes will be judged as non-mistakes after the ultimate legal determination by this court, based on factual findings underlying this determination under substantial evidence standard; Mr. Pal respectfully argues that, in charging the mistakes to Mr. Pal, the Agency adopted positions which are not in accordance with the law.

This Court has established the standards for determining whether the Agency allegation of a mistake to Mr. Pal is legally acceptable. *In re Zurko*, 258 F.3d 1379 (2001), *on remand from Dickinson v. Zurko*, 527 U.S. 150 (1999):

> "We review the ultimate legal determination of obviousness without deference. ... We review factual findings underlying this determination for substantial evidence. *In re Gartside*, 203 F.3d at 1311-16, 53 USPQ2d at 1772-75...
>
> "A review under this [substantial evidence] standard 'involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency's decision.' *In re Gartside*, 203 F.3d at 1312, 53 USPQ2d at 1773...
>
> "Moreover, while appellate courts must respect agency expertise, the [Supreme] Court has 'stressed the importance of not rubber-stamping agency fact finding.'...Indeed, the [Supreme] Court observed that Federal Circuit judges 'will examine [board fact] findings through the lens of patent-related experience – and properly so, for the Federal Circuit is a specialized Court.'"

2a. 10/640,364: Mr. Pal proposed an IPED in examiner's obviousness rejection because (a) primary reference did not teach claim limitations, and (b) the examiner made an impermissible combination with a conflicting secondary reference that taught away from the objective of the primary reference and would destroy the process, if combined. The Agency withdrew the IPED, deleted from record, and charged a mistake to Mr. Pal. Conveniently, Ms. Dudash avoided any further scrutiny anywhere at the Agency.

As discussed in Mr. Pal's brief at 45-47, primary prior art Rohrbach does not teach several claim limitations – an ion-exchange resin, the fuel additive removably bound to the ion-exchange resin by chemical interaction and (later) at least partially removed from the ion-exchange resin by chemical interaction. **A360-A364** Noting the deficiency, the examiner tried to rationalize (and apparently Ms. Dudash agreed with the examiner) that Rohrbach and Drozd "suggested" ion-exchange resin by disclosure of "high surface area and surface modified sorbents" or as "mixture of adsorbents and thermoplastic resins." **A356** There was no teaching reference which supported examiner's rationalization. The examiner and Ms. Dudash appeared to believe that the "suggestion" came from basic knowledge in the art.

Such a situation is discussed in *In re Zurko*, 258 F.3d 1379 (2001). This court stated:

> "This assessment of basic knowledge and common sense was not based on any evidence in the record, and, therefore, lacks substantial evidence support. ... the Board [Board of Appeals at the Agency] cannot simply reach

> conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point out to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise."

This Court will find Agency's underlying findings as unsubstantial evidence. In addition, this Court will find Agency's legal determination to be wrong. The secondary reference Graiff teaches the use of ion-exchange resin to remove impurities (not even fuel additives) from a fuel composition – the opposite of the process and objective of the primary reference. In the obviousness rejection, the examiner made an impermissible combination of the primary reference with a reference that would destroy the primary reference.

Apparently, Ms. Dudash thought examiner's combination to be within the law. Mr. Pal testified and provided the Board with citations of MPEP Sections. **A369** The Board failed to consider this evidence.

The applicant responded to the examiner's rejection substantially in the same manner as Mr. Pal wrote in his comment on the IPED **A371-A375, A360**. The technology center accepted the applicant's arguments and allowed the claims (and would have accepted Mr. Pal's IPED, if Ms. Dudash had sent it).

Mr. Pal respectfully requests this Court to reverse the Agency decision and declare that the board was wrong in sustaining this alleged mistake.

2b. 10/612,149: Mr. Pal found examiner's obviousness rejection of claims 5-10 to be acceptable and made this case a pass through; Ms. Dudash proposed an IPED alleging that the examiner's rationale based on this Court's precedent was inadequate. Not only did technology center refuse to accept her proposed IPED, the examiner, in defiance, repeated the same rejection verbatim when the applicant re-filed the same claims 5-10. In violation of the Agency practice, Ms. Dudash continued to charge a mistake to Mr. Pal, even though he did not propose or agree with her proposed IPED.

Details of Mr. Pal's argument are in the brief at 49-52. The Agency encourages the examiner to follow this Court's rationale when the instant fact situation is substantially same as that in this Court's precedent. MPEP pp. 2100-140 and 2100-146 (enclosed in the Appendix). The applicant did not establish a criticality of the formula limitation. **A412** Mr. Pal presented detailed argument to Ms. Dudash, but failed to persuade her. **A413**

The fact-situation in this case is substantially the same as in *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), cert. denied, 469 U.S. 830 (1984); this Court observed:

> "Differences between the prior art and the claimed invention therefore remain in the dimensional limitation recited in claim 1." (For the specific difference – a formula limitation – see Pal's brief at 51).

At the hearing there was a long discussion with the Administrative Judge, **A234-239** including the introduction of Appellant's Hearing Exhibits 2 (showing that the examiner substantially repeated again the same rejection of the same claim 5-10. **A423-A424** However, the Board totally ignored Mr. Pal's testimony. **A415**

If supervisor proposes an IPED in a pass through case (where the reviewer did not find an IPED), OPQA practice permits the supervisor to charge a mistake to the reviewer only when the technology center readily accepts supervisor's proposed IPED. Such a situation is described by Ms. Dudash in her testimony:

> "[W]hen the TC promptly accepts something that the reviewer has proposed as a pass-through, [and] I have gotten them to send it [my proposed IPED] to the TC, that [my proposed IPED] has been accepted by the TC, that is a very clearcut error [reviewer mistake]." **SA176** (lines 22-25).

In this case, not only did TC refuse to accept her proposed IPED, the examiner repeated the same rejection *verbatim* three more times (the last one entered as Appellant's Hearing Exhibit 2). In describing the review process at the OPQA, Ms. Dudash also testified:

> "[I]f someone in looking at it as well can tell that there's really a difference of opinion versus a difference of facts, I'm unlikely to call that as an error [reviewer mistake]. **SA78** (lines 18-21)

Ms. Dudash did not follow either of the OPQA practices. Mr. Pal respectfully urges this Court to reverse the Board decision and declare that the board was wrong in sustaining this alleged mistake.

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3. 10/724,596: This case involves ultimate legal determination based on the factual findings *underlying this determination for substantial evidence. Although there is no dispute regarding the factual findings, Agency's determination of "new matter" in amended claims was not in accordance with the law; Mr. Pal respectfully requests this Court to reverse the board decision and declare that he was improperly charged with a mistake.*

This case is discussed in Mr. Pal's brief at 43-45. The issue was whether the phrase "wherein one of the terminals is formed from aluminum" in new dependent claims 57 and 65 constituted "new matter" in violation of 35 U.S.C. §112, 1st paragraph (description requirement).

The examiner called it "new matter." **A324** Mr. Pal disagreed and declared an IPED. **A337** Supporting the examiner, Ms. Dudash disagreed with him, withdrew and deleted his proposed IPED from record, and charged a mistake to him, and conveniently, she avoided any further scrutiny.

Applicant originally disclosed in the specification: "Terminals 3 and 4 are aluminum." **A332** Also, claim 26 disclosed "wherein the terminals are aluminum." **A334** Initially, Ms. Dudash agreed with Mr. Pal: "While I agree with you that there is support for 'terminals formed from aluminum…'" **A339**

But, she still considered the examiner's rejection to be proper, and argued (surprisingly Ms. Hutzell agreed, **A338**), which appeared bizarre: "The claims now imply one terminal could be formed from something else." **A339**

There is no disagreement in the underlying findings of facts under the "substantial evidence" standard. But, in ultimate legal determination, this Court should agree that there was support for the amendment – which is the necessary requirement under 35 U.S.C. 1st paragraph, description requirement.

Mr. Pal respectfully urges this Court, on ultimate legal determination based on the underlying findings, to reverse the board decision, and declare that the board was wrong in sustaining this alleged mistake.

...

5. In conclusion, Mr. Pal requests this Court to reverse the board decision on ultimate legal determination and/or "unsubstantiated evidence."

The Administrative Judge totally ignored Mr. Pal's testimony and arguments presented at the hearing. **A234-A250** In Section VI in Pal's brief at 42-53, he has cited this Court's precedents as prevailing law.

At the hearing, Agency counsel (Ms. Belasco) did not challenge Mr. Pal with respect to the patentability issues, and his testimony that Ms. Dudash charged the mistakes in violation of this court's precedents. In the Agency brief, even the Agency counsel did not challenge Mr. Pal's positions and legal analysis. Agency brief at 17

The board totally ignored Mr. Pal's testimony with respect to the six mistakes, supported with citations of statutes, MPEP Sections, and this Court's precedents. **A231-A246**. Particularly, Mr. Pal introduced Exhibits into record comprising short summaries of the issues, arguments, and MPEP citations (which include this court's precedents). **A340-A341, A369, A396-A370, A415**

Mr. Pal provided the Administrative Judge with a copy of MPEP, Chapter 2100, identifying and highlighting the sections (included as an addendum in the Appendix). The Administrative Judge entered the document as Appellant's Hearing Exhibit 3. Because the board ignored these objective documents, its decision was not based on evidence that met this Court's "substantial evidence" standard:

> "A review under this [substantial evidence] standard 'involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency's decision.' *In re Gartside*, 203 F.3d at 1312, 53 USPQ2d at 1773.

APPENDIX H

10/724,596

DOCUMENTS FOR ESTABLISHING THAT THE COURT DECISION REPRESENTS A RADICAL DEPARTURE FROM ITS PRECEDENTS

A. Pal reviewed new dependent claims 57 and 65:

42. (Currently amended) A laminate package for energy storage device having two terminals, the package including:

an inner barrier layer for defining a cavity to contain the energy storage device, the inner barrier having two opposed portions that are sealingly engaged with each other and from between which the terminals extend from the cavity;

a sealant layer being disposed intermediate the inner barrier layer and an adjacent one of the terminals;

an outer barrier layer bonded to the inner barrier layer and having a metal layer; and

tie layers of between [less than] about 1μm and about 10μm thickness being disposed between the inner barrier layer and the [respective] sealant layer and between the inner barrier layer and the outer barrier layer.

49. (Currently amended) A laminate package for an energy storage device having two terminals, the package including:

an inner barrier layer [having a low melting point and a high vicat softening temperature] for defining a cavity to contain the energy storage device;

a sealant layer being disposed between, and being sealingly engaged with, the inner barrier layer and an adjacent one of the terminals; and

an outer barrier layer bonded to the inner barrier layer and having a metal layer, wherein the package sealingly contains the energy storage device and the terminals are accessible from outside the package for allowing external electrical connection to the energy storage device.

57. (New) A package according to claim 42 wherein one of the terminals is formed from aluminum.

65. (New) A package according to claim 49 wherein one of the terminals is formed from aluminum.

B. Pal reviewed the following examiner office action with respect to claims 57 and 65 (excerpt):

15. Claims 54, 57, 60, 62, 65 and 68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter of new claims 54, 57, 60, 62, 65 and 68 is not supported in the specification as originally filed.

C. Pal provided the following reason for finding an in-process examination deficiency (IPED):

At least the new matter rejection of claims 57 and 65 (terminals formed from aluminum) under 35 USC

112, 1st paragraph is wrong since US PUB 20040081778 (applicant's specification) at paragraph 00775-76 provides support for the amendment.

D. Pal showed literal support for the amendment in applicant's original specification:

[0075] Terminals **3** and **4** are aluminum and have a thickness...

[0076] Terminals **3** and **4** are heated...

E. Ms. Dudash's e-mail comments to Pal's proposed IPED:

From: Dudash, Diana
Sent: Tuesday, January 10, 2006, 12:04 AM
To: Pal, Asokkumar
Subject: Proposed IPED of 10/724,596, New Matter issue

Asok,

While I agree with you that there is support for "terminals formed from aluminum", that is not what the claims at issue recite.

I ask you to consider these points:

1) Claims 57 and 65 recite "A package... wherein one of the terminals is formed from aluminum", whereas the paragraphs you recited in the PGPUB document indicate that both terminals are formed of aluminum and I don't see any suggestion in the spec or claims that they be formed of something else. The claims now imply one terminal could be formed from something else.

2) the claims are directed to a laminate package "for an energy storage device having two terminals". Since it is the package that is being claimed, not the energy storage device, it is unclear that the claims at issue really further limit the independent claims.

In other words, whether there is new matter or not, how does the rejection set forth by the examiner impact prosecution enough call an IPED.

I do think the examiner could have been clearer on why the new matter rej was made for all these claims, but if you look at claims 58 and 66, which recite that both terminals formed from aluminum and were not included in the new matter rejection, you can see what the examiner was thinking.

F. Agency alleged an error after a legal determination in the Notice of Proposed Removal (excerpt):

Mr. Pal performed an In-Process Review of this application in which he incorrectly proposed an IPED error on the basis that the examiner's rejection of claims 57 and 65 under [35 U.S.C. §] 112, first paragraph as containing new matter was incorrect. The review stated that "at least the new matter rejection of claims 57 and 65 (terminals formed from aluminum) under [35 U.S.C. §] 112, first paragraph is wrong since US PUB 20040081778 (applicant's specification) at paragraph 0075-76 provides support for the amendment." However, the limitations at issue in claims 57 and 65 differ from the disclosure in the cited paragraphs of the publication, which describe **both** "Terminals 3 and 4 are aluminum." Claim 57 and 65 recite "wherein **one** of the terminals is formed from aluminum" (emphasis added). There is no support in the disclosure for the concept that only one of the terminals is formed from aluminum. Thus, the examiner's rejection of claims 57 and 65 was proper. (bold emphasis original)

G. True copy of Pal's Exhibit discussed during the hearing, summarizing the

arguments and the law, and submitted to Administrative Judge:

Exhibit

In this application, Hutzell/Dudash "created" a reviewer error against the appellant, simply by NOT AGREEING with the Appellant's position, and PREVENTING a second review of Agency's position at the TC level or anywhere within the Agency. Agency's position was **NOT in accordance with patent laws, patent rules and Agency's established procedure as related in MPEP.**

The examiner proposed an improper rejection based on new matter in the amended dependent claims 57 and 65 for the limitation *"one of the terminals is formed from aluminum."* Tab 4e at 329. These dependent claims further limit the scope of the corresponding independent claims asserting *"one of the terminals."* Applicant's specification clearly states: *"Terminals 3 and 4 are aluminum,"* thereby supporting the claimed limitation *"one of the terminals is formed from aluminum"* in these dependent claims.

The examiner's rejection was **not in accordance with patent laws, patent rules and Agency's established procedure as related in MPEP 2161.01** *(the inventor had possession of, as of the filing date of the application relied on").* In this case, applicant's amendments in claims 57 and 65 do not introduce "new matter," since the *"claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure."* **MPEP 2163 (b).** Applicant's disclosure in the specification – *"Terminals 3 and 4 are aluminum"* – explicitly supports the claimed limitation "*one of the terminals is formed from aluminum.*"

The Agency also applies unacceptable patentability standards, Tab 4e at 330:

(a) *"The claims now imply one terminal could be formed from something else."* The Agency's analysis got it wrong – just the opposite – the question was whether the specification expressly or implicitly supported the claim language, not whether the claim language changed the scope of the specification by implication. Tab 4e at 330

(b) "*[I]t is unclear that the claims really further limit the independent claims.*" The Agency's analysis is again wrong: independent claims assert "*one of the terminals.*" Applicant's specification clearly states: "*Terminals 3 and 4 are aluminum,*" thereby further limiting the independent claims by specifying that "*one of the terminals*" in the independent claims is formed from aluminum. Tab 4e at 330

(c) "*[I]f you look at claims 58 and 66, which recite that both terminals are formed from aluminum and were not included in the new matter rejection, you can see what the examiner was thinking.*" The Agency is applying wrong patentability standards by reading the limitations from a second claim into the first claim when the first claim is not dependent from the second claim. Also, the independent claims required "one of the terminals," NOT "both" of the terminals. The examiner and the Agency were thinking wrong, not in accordance with the **Agency's established** procedures regarding claim interpretation.

H. Transcript (pp. 118-119) of Ms. Dudash's testimony at the hearing:

Q. Okay. And upon completing your review, what did you believe? Did you agree with him?

A. No.

Q. Why not?

A. Because upon looking at the records, looking at the examiner's explanation, looking at other claims and the record, the portion Md. Pal had referenced, the specification, the record provided support for both of the claimed terminals to be aluminum. The claims, the new claims that were proposed as rejected as new matter were directed to the concept that one of the terminals could be aluminum.

Q. And is that significant?

A. Yes, it would be significant.

Q. Why?

A. Because if – it basically gives the implication – it's saying one of the terminals is aluminum, but it leaves wide open the other terminal could be something else. That is not what the spec provided support for.

APPENDIX I

10/640,364

DOCUMENTS FOR ESTABLISHING THAT THE COURT DECISION REPRESENTS A RADICAL DEPARTURE FROM ITS PRECEDENTS

A. Pal reviewed the claims of which claim 1 is representative:

1. (CURRENTLY AMENDED) A device for delivering at least one fuel additive to a fuel, said device comprising an ion-exchange resin to which [is removably attached] a fuel additive is removably bound by a chemical interaction, wherein the ion-exchange is selected from the group consisting of anionic exchange resins and cationic exchange resins, and wherein the fuel additive is at least partially removed from the ion-exchange resin by means of a chemical interaction.

B. Pal reviewed the following examiner action (excerpt):

Claims 1,2,4,5,7-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbach et al patent 6,379,564 in view of Drozd et al patent 6,835,218 and Graiff et al patent 5,300,218.

For claims 1 and 17-19, Rohrbach et discloses a filter device for filtering fuel or other viscous hydrocarbon fluids, comprising an adsorbent reagent that may be a high surface area sorbent, having a releasably attached fuel additive (see especially column 6, lines 20-28, column 7, lines 40-49, column 13, lines 41-50 and column 14, lines 22-31). The device of Rohrbach et al also causes reactions, i.e., "chemical interactions" with the fuel being treated (column 6, lines 24-26, column 14, lines 27-31). With regard to claim 17, the casing of the fuel filter defines a chamber. For claim 18, the inlet to the fuel filter continually provides fuel from a supply line upstream of the filter and for claim 19, see also column 3, lines 48-51 concerning slow controlled release of additive.

The claims all differ in explicitly requiring the adsorbent that releases the additive to be disclosed as an ion-exchange resin. Rohrbach et al suggest materials functionally similar to "ion-exchange resin" by disclosure of "high surface area and surface modified sorbents: that may have "high binding acitivities" [sic] and may be of resin forming polymeric material "organic salts...amines, polyamines, polyimines..." and neutralizing agents including zeolites and modified zeolites and activated carbon (column 7, lines 45-49 and 61-67). Drozd et al further suggest "ion-exchange resin" by teaching of mixture of adsorbents and thermoplastic resins" (column 13, lines 6-10). Graiff teaches purification of fuels prior to their use/combustion in engines, by passing the fuel through a bed containing adsorbents including one or more of activated carbon, zeolites and ion exchange resins/at least of the anionic exchange type (especially column 2, lines 2-41.

Thus, it would have been obvious to one of ordinary skill in the art to either have considered the additive releasing sorbents of Rohrbach et al to encompass "ion exchange resin" or to supplement or substitute with ion exchange resin, since Drozd et al teach that additives are controllably released, at a well controlled rate (see further column 2, lines 34-

36 of Drozd et al) from mixtures of adsorbents and thermoplastic resins (i.e. resins having ion containing fuel impurity adsorbent properties, the impurities being adsorbed being exchanged with the fuel additive; and since Graiff et al teach that each of activated carbon, zeolites and ion exchange resins reduce various types of fouling, gumming and deposits present in the fuel."

C. Pal provided the following reasons for finding an in-process examination deficiency (IPED):

All independent claims require the presence of ion-exchange resins with removably bound "Fuel additive," wherein "the fuel additive is at least partially removed from the ion-exchange resin by means of a chemical interaction." This does not introduce a new matter since original claims 6 and 7 support removal of fuel additive from the ion-exchange resin by "chemical interaction."

The prior art references Rohrbach (6379564), Drozd *[()6835218) and Graiff (5300218) do not teach the use of ion exchange resins to removably hold the fuel additive and then release by chemical interaction with a component in the fuel. The examiner rationalizes that Rohrbach suggests "materials functionally similar to "ion exchange resin" by disclosure of "high surface area and surface modified sorbents" that may have "high binding activities" and may be of resin forming polymeric material "organic salts...amines, polyamines, polyimines..." Graiff teaches the process of purification of fuels by passing through an ion exchange resin, but not addition of fuel additives.

The rejection lacks teaching with respect to the significant claim limitations – the use of ion-exchange resins removably holding a fuel additive, which can be at least partially exchanged with fuel components by chemical interaction. Also, the rejection lacks motivation why one reading the prior art references would have been lead [sic, led] to specifically select and use ion-exchange resins in a device or apparatus or method for time-release (by chemical interaction) of additives adsorbed on ion-exchange resins, without the benefit of reading applicant's disclosure. The examiner has improperly relied on hindsight reconstruction after reading the applicant's disclosure and not from teachings in the prior art references.

D. In the Notice of Proposed Removal, the agency alleged an error after a legal determination under 35 U.S.C. §103 (excerpt):

Mr. Pal completed an In-Process Review of this application in which he incorrectly proposed an IPED error on the basis that the [35 U.S.C.§] 103 rejection of claims 1, 2, 4, 5, 7-9 and 11-19 over Rohrbach et al (U.S. 6,379,564) in view of Drozd et al. (U.S.6,835,218) and Graiff et al.(U.S. 5,300,218), was unreasonable. The review stated that the cited references "do not teach the use of ion exchange resins to removably hold the fuel additive and then release by chemical interaction with a component in the fuel" as required by the claims (see representative claim 1, below) and further, that the rejection lacks proper motivation to combine the teachings of the cited art. Upon review by the Supervisory RQAS, it was determined that the prior art references cited in the [35 U.S.C.§] 103 rejection did meet the limitations of the claims. See, for example, Rohrbach at col. 3, lines 48-52; col. 6, lines 20-28; col. 7, line 40; col. 8. line 31; col. 10, lines 45-52; and col. 14, lines 22-31; Drozd, at col. 2, lines 34-46; col. 3; col. 13, lines 6-10 and Graiff, at col. 1, line 30-col. 3, line 41. Further the prior art supplied motivation to combine the teachings of the references to render the claims obvious. Rohrbach et al. teaches making filters, including fuel filters, with filters supplied with a chemical reagent therein. Rohrbach et al. teaches the reagents may adsorb contaminants or supply additives by slowly releasing a particular additive (see for example col. 3, lines 48-52; col. 8, lines 7-31; col. 14, lines 22-31. Reagents are more specifically discussed in col. 7, line 40-col. 8, line 4, including activated carbon, zeolites and modified zeolites, other high surface area sorbents including surface modified sorbents, or combinations. Column 10, teaches that a plurality of different reagents/additives may be incorporated in the non-woven web. Drozd et al. teaches fuel additive compositions comprising a sustained release component and an additive component to be released into a fuel (see for example col. 2, lines 34-36; and col. 3). The sustained release component includes a variety of polymeric materials, including adsorbents (see for example col. 13, lines 6-10). Graiff et al. uses the ion exchange resin as an adsorbent for treating (selective removal of contaminants from), e.g., diesel fuel. Graiff et al. also teaches preferred adsorbents "are selected from the group consisting of acid zeolites, strong acid ion exchange resins, alumina, acid activated carbon" (see for example col. 1, line 30-col. 3, line 41). Therefore the [35 U.S.C.§] 103 rejection set forth in the Office action was proper. RQAS Pal was requested to modify the review form to remove the indication of an IPED error with respect to the [35 U.S.C.§] 103 rejection.

E. True copy of Pal's Exhibit supporting Pal's testimony at the hearing, summarizing the arguments and the law, and submitted to Administrative Judge:

Exhibit
10/640,364 (Tab 5d in Notice of Proposed Removal)
Tab 4e at 292 – 327.

In this application, Hutzell/Dudash "created" a reviewer error against the appellant, simply by NOT AGREEING with the appellant's position, and PREVENTING a second review of Agency's position, Agency's position was **NOT in accordance with patent laws, patent rules and Agency's established procedure as related in MPEP.**

First, the examiner, as well as the Agency, failed to appreciate the technology of the claimed invention; secondly, the examiner and Agency misunderstood the technology in the prior art. Tab 4e at 293. The Agency ignored two key claim limitations: (a) "*device comprising an ion-exchange resin to which a fuel additive is removably bound by a chemical interaction*" and (b) "*wherein the fuel additive is at least partially removed from the ion-exchange resin by means of a chemical interaction.*" Tab 4e at 293. The examiner's obviousness rejection, Tab 4e at 308, did not address these issues in his action.

The examiner failed to follow **Agency's established** procedures as related in **MPEP 2141.02, Section I** (*THE CLAIMED INVENTION AS A WHOLE MUST BE CONSIDERED).* The examiner, in applying the prior art, failed to address the two claimed limitations. Secondly, the primary reference (Rohrbach) fails to teach the key limitation "*ion-exchange resin*" anywhere in it, and the adsorbents in Rohrbach involve no "*chemical interaction.*" Claims require "*chemical interaction*" in both the adsorption process and in the subsequent removal process.

Also, the examiner improperly combined a primary reference (Rohrbach) with a conflicting secondary reference (Graiff), which taught a process opposite to the primary reference. Tab 4e at 294. The examiner's rejection was **NOT in accordance with patent laws, patent rules and Agency's established procedure as related in MPEP 2141.03, Section VI** (*The prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."*), **MPEP 2143.01, Section I** (*THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION*), **MPEP 2143.01, Section V** (*THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE*), and **MPEP 2143.01, Section VI** (*THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE*).

APPENDIX J
10/612,149
DOCUMENTS FOR ESTABLISHING THAT THE COURT DECISION REPRESENTS A RADICAL DEPARTURE FROM ITS PRECEDENTS

A. Pal reviewed the following claims:

5. (Currently Amended) The film-forming apparatus as set forth in claim 1, wherein the apparatus is so designed that the inner diameter of the film-forming chamber and the diameter of the shower head satisfy the following relation:

(The diameter of the shower head) x 1.5 </= (The inner diameter of the film-forming chamber) </= (The diameter of the shower head) x 2.5

6. (Original) The film-forming apparatus as set forth in claim 5, wherein the relation holds true when the pressure in the film-forming chamber, the diameter of the shower head and the overall flow rate of gases upon the formation of the film satisfy the following relations, respectively:

2 Torr < (The pressure in the film-forming chamber) < 10 Torr

The diameter of the substrate to be processed < /= (The diameter of the shower head) x 1.5

2500 sccm < (The overall flow rate of gases) < 7000 sccm

7. (Currently Amended) The film-forming apparatus as set forth in claim 1, wherein the apparatus is so designed that the distance between the shower head (S) and the substrate (S) to be

processed (S/S distance) satisfies the following relation:

(S/S distance) x 5 </= (The diameter of the shower head) </= (S/S distance) x 10.

8. (Original) The film-forming apparatus as set forth in claim 7, wherein the relation holds true when the pressure in the film-forming chamber, the diameter of the shower head and the overall flow rate of gases upon the formation of the film satisfy the flowing relations, respectively:

2 Torr < (The pressure in the film-forming chamber) < 10 Torr

The diameter of the substrate to be processed [< /=] (The diameter of the shower head) x 1.5

2500 sccm < (The overall flow rate of gases) < 7000 sccm

9. (Currently Amended) The film-forming apparatus as set forth in claim 1, wherein the clearance for exhaustion of this apparatus satisfies the relation represented by the following equation"

0.02 m^2/s < Exhaustion Conductance < 0.08 m^2/s.

10 (Original) The film-forming apparatus as set forth in claim 9, wherein the equation holds true when the pressure in the film-forming chamber, the diameter of the shower head and the overall flow rate of gases upon the formation of the film satisfy the following relations, respectively:

2 Torr < (The pressure in the film-forming chamber) < 10 Torr

The diameter of the substrate to be processed < /= (The diameter of the shower head) x 1.5

2500 sccm < (The overall flow rate of gases) < 7000 sccm

B. Pal reviewed the following examiner Office Action (December 2005) (excerpt):

Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okase; Wataru US 5,884,009). Okase is discussed above[4]. Okase does not teach the relative dimensions of Okase's showerhead (7c; Figure 7; column 15, lines 6-67) diameter vs. Okase's film-forming chamber (between 61 and 7c; Figure 7; column 15, lines 6-67) diameter as claimed by claim 5. Okase does not teach the relative distance between Okase's substrate (W) and Okase's showerhead (7c; Figure 7, column 15, lines 6-7) as claimed by claim 7. Okase further does not teach the operating parameters of pressure and gas flow in the range of the claimed inequalities – claim 6, and 8-10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize Okase's relative apparatus dimensions and Okase's operating parameters.

Motivation to optimize relative apparatus dimensions and Okase's operating parameters is for generating uniform thickness of deposited films as taught by Okase (column 13, lines 20-30). Further, it would be obvious to those of ordinary skill in the art to optimize the operation of the claimed invention. (In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969); Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d

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[4] The examiner rejected claim 1 as anticipated by Okase. The agency, and Pal agreed with the examiner's rejection of claim, showing all the components – item-by-item. The claimed apparatus had all the components and functioned in the same manner as taught in Okase.

1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990), MPEP 2144.05). Further, it is well established that changes in apparatus dimensions are within the level of ordinary skill in the art. (Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); In re Rose 220 F.2d 459, 105 USPQ 237 (CCPA 1955); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); See MPEP 2144.04)

C. Since Pal did NOT find an in-process examination deficiency (IPED), he did not make a statement; the following is an explanation:

Pal found the examiner's rejection of claims 5-10 reasonable, particularly since the examiner followed the rationale in agency's MPEP 2144.04 and cited *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), and since the fact situations in this application were identical with the fact situation in *Gardner*. MPEP specifically encourage examiners to follow the rationale in court precedents under similar fact-situations.

D. Ms. Dudash decided that the examiner's rejection of claims 5-10 was in violation of 35 U.S.C. 103; she composed an obviousness rejection and sent it to the examining group. The agency (Examining Group TC1700 Director) rejected her position; in defiance, the examiner repeated the same rejection of the same claims 5-10 verbatim more three times.

E. Even when the applicant re-filed the claims, the agency rejected the same claims 5-10 and repeated (March 16, 2007) the text essentially verbatim (Note: The changes from the above (December 2005) rejection (Section B above), reviewed rejection are highlighted in bold):

Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okase; Wataru (US 5,884,009 A). Okase is discussed above. Okase does not teach the relative dimensions of Okase's showerhead (7c; Figure 7; column 15, lines 6-67) diameter vs. Okase's film-forming chamber (**volume within 7c+piece containing 45**; Figure 7; column 15, lines 6-67) diameter as claimed by claim 5. Okase does not teach the relative distance between Okase's substrate (W) and Okase's showerhead (7c; Figure 7, column 15, lines 6-7) as claimed by claim 7. Okase further does not teach the operating parameters of pressure and gas flow in the range of the claimed inequalities – claim 6, and 8-10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize Okase's relative apparatus dimensions and Okase's operating parameters. Motivation to optimize relative apparatus dimensions and Okase's operating parameters is for generating uniform thickness of deposited films as taught by Okase (column 13, lines 20-30). Further, it would be obvious to those of ordinary skill in the art to optimize the apparatus of the claimed invention (In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969); Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843

(Fed. Cir.), cert. denied, 493 U.S. 975 (1989); In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990), MPEP 2144.05). Further, it is well established that changes in apparatus dimensions are within the level of ordinary skill in the art. (Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); In re Rose 220 D+F.2d 459, 105 USPQ 237 (CCPA 1955); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); See MPEP 2144.04)

F. During hearing, Pal testified and submitted the following as an Exhibit.

Exhibit
10/612,149 (Tab 5b in Notice of Proposed Removal)
Tab 4e at 243 – 271

The examiner provided an excellent prior art and a comprehensive analysis that conclusively established the anticipation of the most generic, independent claim 1. OPQA requires the reviewers to consider the generic, independent claim only. Agency found no fault in reviewer's analysis of examiner's anticipation rejection of claim 1.

The Agency, instead, improperly focused on dependent claims 5 – 10, which include a formula relating the diameters of two components in the apparatus. In the specification the inventor did not establish the criticality of the ratio of the diameters.

First, according to the prevailing policy of OPQA, reviewers are not required to review the propriety of dependent claims. The Agency applied this prejudiced standard to the appellant, while not applying the same standard to other fellow reviewers.

Secondly, Agency's position with respect to the patentability of claims containing a formula was **not in accordance with the patent laws, rules and Agency's established procedures as related in the MPEP 2144.04, Section IV, A citing *Gardner*.** Tab 4e at 245. Finally, Agency made an error by visually comparing the diameters of the components in the prior art drawing to calculate a ratio, which is **not in accordance with the patent laws, rules and Agency's established procedures as related in the MPEP 2125** *(PROPORTIONS OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE...Patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.)*

G. With respect to this case, Administrative Judge made the following comments during hearing (hearing transcript at 435, 446):

JUDGE TURBITT: We have agreed that the application number applies to the same number which is 10/612149. I am going to mark as Appellant's Hearing Exhibit Number 1 the one with the date mailed – the mail date – of 12/14/05. Is that understood?

MS. BELASCO (Agency Counsel): Yes.

JUDGE TURBITT: And I'm marking as Appellant's Hearing Exhibit Number 2 the same application number but the mail date is 3/16/2007. Okay?...

JUDGE TURBITT: Okay. So does the agency object to this document being admitted as Appellant's Hearing Exhibit 3?

MS. BELASCO: We don't. I believe it was for the convenience of yourself in reviewing and checking the citations that Mr. Pal made in some of his documents, so we have no objection.

JUDGE TURBITT: Okay. I am admitting Appellant's Hearing Exhibit 3 which is a copy of annotated version of the MPEP [Chapter 2100] into record without objection.

MR. RIGBY (Pal's counsel): And I will approach the bench and give them to your Honor now.

JUDGE TURBITT: Thank you, sir.

MS. BELASCO: Judge, the agency would also respectfully request an opportunity to call one rebuttal witness. There were two points raised by Mr. Pal in his testimony that we would like to rebut. I can do it in literally three sentences and my witness in available. She's here right now[5].

JUDGE TURBITT: Mr. Rigby?

MR. RIGBY: I'll object for the record, but I'll obviously accept whatever your Honor takes.

JUDGE TURBITT: Okay. You may present the rebuttal testimony.

H. In the Notice of Proposed Removal, the agency alleged an error after a legal determination under 35 U.S.C. §103 (excerpt):

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[5] Ms. Belasco recalled Pal's supervisor, Ms. Dudash, but did not challenge Pal's testimony on patentability, nor did she seek rebuttal from Ms. Dudash with respect to the patentability issues.

Mr. Pal performed an In-Process Review of this application in which he failed to propose an IPED error on the basis that the rejection of claims 5-10 under 35 USC 103 over Okase et al. (U.S. 5,884,009) was correct. Upon review by the Supervisory RQAS, it was determined that the rejection of claims 5-10 under 35 USC 103 over Okase (U.S. 5,884,009) contained deficiencies that constituted an IPED error. Specifically, the reference fails to meet all the limitations of claims 5-10 (representative claims presented below). For example, it does not teach that the inner diameter of the film-forming chamber and the diameter of the shower head satisfy the following relation: "(The diameter of the shower head) x 1.5 </= (The inner diameter of the film-forming chamber) </= (The diameter of the shower head) X 2.5" as recited in claim 5, lines 5-6; and "wherein the relation holds true when the pressure in the film-forming chamber, the diameter of the shower head and the overall flow rate of the gases upon the formation of the film satisfy the following relations, respectively: 2 Torr < (The pressure in the film-forming chamber) < 10 torr[.] The diameter of the substrate to be processed </= (The diameter of the shower head) x 1.5. 2500 sccm < (The overall flow rate of gases) < 7000 sccm" as recited in claim 6, lines 2-8. Furthermore, there is no motivation in the cited prior art nor any scientific reasoning provided to establish motivation to modify the reference in order to meet the specific limitations and relationships of variables as claimed. In the rejection the examiner acknowledged that the specific limitations of the claims are not met by the reference.

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Supreme Court, U.S.
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No. 081071

IN THE
Supreme Court of the United States

Asokkumar Pal, pro se
Petitioner
v.
Department of Commerce
Respondent

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SUPPLEMENTAL APPENDIX

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February 19, 2009

SUPPLEMANTAL APPENDIX

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SUPPLEMENTAL APPENDIX A

Decision of the Administrative Judge Merit Systems Protection Board (True Copy)

UNITED STATES OF AMERICA MERIT SYSTEMS PROTECTION BOARD WASHINGTON REGIONAL OFFICE

ASOKKUMAR PAL Appellant, v. DEPARTMENT OF COMMERCE Agency	DOCKER NUMBER DC-0432-07-0158-1-2 DATE: July 27, 2007

John J. Rigby, Esquire, Arlington, Virginia, for the appellant.

Caitlin Riley, Esquire, Arlington, Virginia, for the agency.

BEFORE
Daniel Madden Turbitt
Administrative Judge

INITIAL DECISION

On March 29, 2007, Asokkumar Pal (the appellant) refiled appeal challenging an action of the Department of Commerce (the agency), which removed him from his GS-1220-15 position of Patent Review Quality Assurance Specialist at the agency's Patent and Trademark Office, Patent Quality Assurance, in Alexandria, Virginia, effective November 3, 2006. The Board has jurisdiction over this appeal under 5 U.S.C. § 4303(e). At the appellant's request, a hearing was held in this matter.

Based on the following analysis and findings, the agency's action is AFFIRMED.

ANALYSIS AND FINDINGS

Background

The following facts are undisputed. The United States Patent and Trademark Office (PTO) is established as an agency of the United States, within the Department of Commerce. 5 U.S.C. § 1. The PTO is responsible for granting and issuing patents, registering trademarks, and disseminating to the public information with respect to patents and trademarks. 35 U.S.C. § 2(a).

The appellant began his employment with the PTO as a Patent Examiner on September 20, 1981, as a GS-1224-09, step 1. Appeal File (AF), Tab 8, Subtab 4u. The agency promoted the appellant as follows: (1) on October 3, 1982, to a GS-1224-11, step 1; (2) on October 16, 1983, to GS-1224-12, step 1; (3) on October 28, 1984, to GS-1224-13; and (4) on December 21, 1986 to a GS-1224-14, step 1. AF, Tab 8, Subtabs 4t, 4s, 4r, and 4q. Effective February 16, 1997, the appellant was selected as a Patentability Review Examiner, GS-1220-15, step 5. *See id.*, Subtab 4n. On January 12, 2003, he was reassigned to the position of Patent Examiner, GS-1224-15, step 7, in the Office of Patent Quality Review (OPQA). *See id.*, Subtab 4m.

At all times relevant to this appeal, the appellant was employed as a Patent Examiner, Review Quality Assurance Specialist (RQAS), GS-1220-15, step 8.

See id., Subtab 4a. The appellant's duties as an RQAS consisted of reviewing the quality of patent examination work products produced by Patent Examiners and developing and giving training to address any needs for quality improvement. *See id.*, Subtabs 4j and 4l.

The appellant signed and acknowledged receipt of his Fiscal Year (FY) 2005 performance appraisal plan (PAP) on May 4, 2005. *See id.*, Subtab 4l. He also signed and acknowledged receipt of his FY 2006 PAP on December 8, 2005. *See id.*, Subtab 4j at 1.

The appellant's critical performance elements contained in both his FY 2005 and 2006 PAPs[1] were: (1) Quality Monitoring; (2) Production/Timeliness of Reviews; (3) Training; and (4) Effective Leadership of Quality Improvement. *See id.*, Subtabs 4j and 4l.

Diana L. Dudash became the appellant's first-level supervisor after mid-year of FY 2004. AF, Tab 8, Subtab 4l. She remained his first-level supervisor until the time of his removal. *See id.*, Subtab 4b. In FY 2006 and at the time of his removal, the appellant's second-level supervisor was Paula Hutzell, OPQA Director. *Id.* At 1. Hutzell reports to Deputy Commissioner for Patent Operations Margaret A. Focarino. On December 8, 2005, Hutzell gave the appellant a written warning that his performance for FY 2005 was "Unacceptable" in two critical elements, Quality Monitoring and

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[1] The performance appraisal system articulates written performance standards for PTO employees. A letter from the Office of Personnel Management (OPM) states that the system was approved by OPM. *See* Appeal File (AF), Tab 8, Subtab 4o-4p. In this case, the appellant is not contesting that the agency performance appraisal system was approved by OPM.

Training. AF, Subtab 4j. In the December 8, 2005 document, Hutzell informed the appellant that his performance improvement period (PIP) to demonstrate performance above the "Unacceptable" level would run December 11, 2005 to March 18, 2006. *Id.*

As a result of the "Unsatisfactory" rating, the appellant was placed on a PIP. The agency claimed that the appellant did not perform adequately during the PIP. The agency alleged that he made six errors and further claimed that these six errors were made in 16 cases that were reviewed by the appellant's supervisor. The appellant completed reviews of 139 cases during the entire PIP. During the PIP, Dudash provided the appellant with feedback concerning his work. AF, Subtab 4h at 15-16, 102-06, 235-38, 240-44, and 290. Hutzell also met with the appellant briefly on two occasions associated with the actions against him during her period as his second-level supervisor.

By letter dated august 3, 2006, Hutzell proposed to remove the appellant based on his "Unacceptable" performance in the critical element of Quality Monitoring during the PIP. AF, Subtab 4h. Hutzell claimed that the appellant's error rate at the end of his PIP was 37.5 percent. *Id.* At 2. She also set forth an explanation of the six errors he committed during the PIP. *Id.* The appellant replied both orally and in writing, to the notice of proposed removal. *See id.*, Subtabs 4e, 4f, and 4g.

On November 2, 2006, Focarino issued a Decision on the Proposed Removal, removing the appellant from Federal service, effective November 3, 2006. AF. Tab 8, Subtab 4b. The removal decision letter was delivered to the appellant on November 3, 2006. *Id.* In the decision letter, Focarino found that while the appellant's performance in the critical element of Training had improved during the PIP, his performance in the critical element of Quality Monitoring did not, as his error rate of 37.5 percent was "Unacceptable." *Id.* At 2. Accordingly, Focarino removed the appellant, purportedly based on his alleged "Unacceptable" performance during the PIP in the critical element of Quality Monitoring. *Id.* This appeal followed. AF, Tab 1.

The agency must support its action by substantial evidence.

The Board will only sustain an agency's removal action taken under the authority of 5 U.S.C. Chapter 43 if is supported by substantial evidence. Substantial evidence is the degree of relevant evidence that a reasonable person, considering the record as a whole, might accept as adequate to support a conclusion, even though other reasonable persons might disagree. 5 C.F.R. § 1201.56(c)(1). The agency has the burden of proving by substantial evidence that: (1) the action was taken under a performance appraisal system approved by the Office of Personnel Management (OPM); (2) the performance standards were valid; (3) the appellant's performance was deficient in at least one critical element as charged; and (4) the agency provided the appellant with a reasonable opportunity to demonstrate acceptable performance. *See Kadlec v. Department of the Army*, 49 M.S.P.R. 534, 539 (1991).

The agency has established by substantial evidence that OPM approved the agency's appraisal plan.

The fundamental basis of a Chapter 43 action is an OPM-approved performance appraisal. *See Griffin v. Department of the Army*, 23 M.S.R.P. 657, 662 (1984). The parties stipulated that the agency's appraisal system has been approved by OPM.[2] Refiled Appeal File (RAF), Tab 12. The agency also submitted evidence to show that its performance plan has been evaluated and approved under OPM-approved system. *See* AF, Tab 8, Subtabs 4o-4p. Thus, I find that, at the time of the appellant's removal, the agency had an OPM-approved performance plan.

The agency has established that the performance standards were valid.

The agency is required to establish performance standards that will, to the maximum extent possible, permit an accurate evaluation of job performance on the basis of objective criteria related to the job. 5 U.S.C. § 4303(b)(1). Performance standards must be reasonable, adequate to inform the employee of the level of performance necessary to achieve a satisfactory or acceptable rating, and sufficient, given the circumstances, to permit accurate measurement of the employee's performance. *See Wilson v. Department of Health & Human Services*, 770 F.2d 1048, 1052 (Fed. Cir. 1985). The standards must be more or less objective depending on the job measured, but must be sufficiently specific to provide the employee a firm benchmark toward which he must aim his performance. *See Melnick v. Department of Housing & Urban Development*, 42 M.S.P.R. 93, 98-99 (1989), *aff'd*, 899 F.2d 1228 (Fed. Cir. 1990) (Table).

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[2] *See* footnote 1, *supra*. A stipulation will satisfy a party's burden of proving the fact alleged. *See* 5 C.F.R. § 1201.63; *Swift v. Office of Personnel Management*, 48 M.S.P.R. 441, 445 (1991).

Similarly, the fact that performance standards may call for a certain amount of subjective judgment by the supervisor does not render them invalid especially where the appellant's position involves the type of professional judgment which is not susceptible to a mechanical rating system. *Neal v. Defense Logistics Agency*, 72 M.S.P.R. 158, 161-62 (1996); *Hsieh v. Defense Nuclear Agency*, 51 M.S.P.R. 521, 528 n.3 (1991), *aff'd*, 979 F.2d 217 (Fed. Cir. 1992)(Table).

One critical element is at issue in this appeal. The failure to perform in a single critical element is sufficient to sustain a charge of unacceptable performance under Chapter 43.

I have reviewed the performance standards in question, and I conclude that they are reasonable, adequate to inform the appellant of the level of performance necessary to achieve a satisfactory or acceptable rating, and sufficient, given the circumstances, to permit accurate measurement of his performance. In reaching this conclusion, I have reviewed the standards themselves. I also considered that the appellant is not claiming in this appeal that he did not understand his standards or that they were confusing to him. In addition, there does not appear to be any dispute that the performance standards were communicated to the appellant. I considered, moreover, stipulations and evidence supporting the agency's assertion that the appellant's first and second level supervisors met with the appellant and sent him periodic e-mails to review the status of assignments and tasks during the PIP. RAF, Tab 12. Hence, I find that the appellant's performance standards permitted an accurate appraisal of his performance, based on objective criteria and that he was afforded adequate assistance. *See Goodwin v. Department of the Air Force*, 75 M.S.P.R. 204, 207-08 (1997); *Gjersvold v. Department of the Treasury*, 68 M.S.P.R. 331, 335-36 (1995).

The agency alleged that the appellant's performance in critical element 1 was deficient.

The critical element at issue, critical element 1, is titled "Quality Monitoring," and the objective of this element is to continuously improve the quality of the Technology Center examination process. AF, Tab 8, Subtab 4j at 4. The Quality Monitoring critical element measures the quality of how well a GS-15 RQAS reviews work performed by Patent Examiners and accounts for 35 percent of the total evaluation. *Id.* The major activities of the quality critical element for GS-15 RQAS are as follows:

1. Reviewing the level of quality of the [Technology Center], Group, and workgroup examination work process and on individual Examiner's work products. The reviews include any of Allowances, In-process Review cases and [Patent Cooperation Treaty] cases. Reviews of other cases as determined by management may be included.

2. Assessing the level of quality of the work product according to established standards.
3. Determining whether the work product being reviewed contains examination errors as determined by the established guidlelines [sic].
4. Making accurate determination of whether the errors found when conducting IPR reviews represent errors that are classified as "[In process examination deficiency]" type errors according to established guidelines.
5. Making accurate determinations of any patentability type errors found in Allowance reviews.
6. Completing [Office of Patent Quality Assurance] review forms based on individual case reviews.
7. Accurately and effectively providing feedback to the appropriate technology center based on the review findings.

AF, Tab 8, Subtab 4j at 4; Subtab 4l at 5.

Under the appellant's FY 2006 PAP, an RQAS' performance in the Quality Monitoring critical element is "Unacceptable" if, among other things, he has an error rate greater than 25 percent with respect to the accuracy of identifying errors in Patent Examiners' work.[3] *Id.* The error rate is determined by dividing the number of incorrect determinations of error or non-error by the total number of cases reviewed by the Supervisory RQAS.[4] *Id.*

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[3] The error rate for Unacceptable performance in the 2005 PAP (greater than 30 percent) is different from the error rate in the 2006 PAP (greater than 25 percent).

The criteria for evaluation in this critical element include the accuracy of reviews where an RQAS finds an error, called an "in process examination deficiency" or "IPED," as well as the accuracy of the reviews where the RQAS finds no error, called a "pass through." *Id.* The PAP states that a minimum of two pass through reviews per quarter will be considered for each RQAS. *Id.*

The agency rated the appellant's performance unacceptable in critical element 1 for several reasons. The PIP notice reflects that the appellant's performance was considered unacceptable because during FY 2005 he had an error rate at least 34%. The agency complained that the work products he submitted consistently required major revision because they were technically inadequate, incomplete or inaccurate, and lacked the content and clarity necessary to communicate the position of OPQA. Further, the agency asserted that, in numerous instances, the appellant's lack of cooperation with his supervisor and co-workers obstructed the successful completion of the work. *See Id.*

According to the PIP notice letter, in order for the appellant to reach the fully successful level under critical element 1, his error rate could not exceed 25%. He also was required to independently perform thorough and accurate quality review so that very few cases would be returned to him for revision. *See id.*

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[4] The PAP uses the acronym "QL," which stands for Quality Lead, the former title of what is now the Supervisory RQAS.

Hutzell provided great detail in the notice of proposed removal of the appellant's alleged performance problems under this critical element. In particular, she listed his performance errors on six cases. Hutzell noted, among other things, that the appellant's work products required major revisions because they were incomplete or inaccurate in content. She also wrote that he failed to apply adequate technical knowledge to complete his work. She described the work product he produced as being "technically inadequate." Hutzell also indicated that the appellant's lack of teamwork prevented him from satisfactorily completing his work. After reviewing a summary of appellant's cases, Hutzell concluded that the evidence clearly established that he failed the improvement period in the critical element of Quality Monitoring. AF, Tab 8, Subtab 4h.

The agency has met its burden of proving that the appellant's performance in critical element 1 was deficient as charged.

At the heating, both the agency and the appellant presented witnesses' testimony to support their conflicting views on whether the appellant's performance in critical element 1 was, or was not, acceptable. Diana L. Dudash testified that she has worked in the Federal government for 17 years. She said that she has been employed as a RQAS Supervisor since may 1, 2004. She has held several jobs at the PTO, including having been a Supervisor Patent Examiner. She also was a Patent Examiner for 10 years.[5]

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[5] A deposition transcript for Dudash is contained in the file at RAF, Tab 9, Appellant's Exhibit CC.

Dudash was the appellant's first-level supervisor. She described the functions of the OPQA, where she and the appellant worked. She indicated that the office reviews the work of Patent Examiners. She noted that Patent Examiners, who must have a degree in science or engineering, make conclusions about the issues in a case and resolve any problems concerning why an application is not currently patentable. OPQA then reviews the Patent Examiner's determinations on those matters. She said that the agency often tries to give the inventors the "benefit of the doubt." In fact, an applicant is given a second chance if his or her claim is rejected.

Dudash explained that GS-15 RQAS (or "Reviewers"), such as the appellant, occupy management positions. They, too, need to have a degree in science and engineering. She said that the four RQAS who work for her all review Patent Examiner's work products, including claims, specifications, office actions, drawings, and other material. An RQAS then looks at the OPQA's standards to see if there are any errors. If there are no issues raised, then the case is considered a "pass through." She explained that most cases are deemed "pass through" reviews. If, however, there is an issue because of an error, then the RQAS fills out a form, called an IPED page, for an "in process review," when a claim is not allowed (deemed not patentable). If there are any errors, then the OPQA usually sends the case back to the Technology Center. If a patent applicant's or an inventor's claim is rejected, it is because it does not comply with laws concerning utility or satisfy grounds.

Dudash said that she generally reviews only those cases where an issue has been raised on a claim. She does not review any "pass through" claims. Dudash reviews her staff's work, such as their fact checking and their analysis, to ensure they are making reasonable arguments. She sometimes has to strengthen a Reviewer's writing or argument so that the application and review will be successful. She assesses how well her reviewers are performing by looking at how much work or corrections she must do for them. From that, she gets a sense of whether she can trust them and whether they are making sound judgments. If an Reviewer needs to do several drafts of a routine write up, then this would be a factor that she might consider in evaluating his or her performance.

Dudash stated that Quality Monitoring is one of the critical elements for Reviewers. She reviews a "handful" of claims (at least two) for each Reviewer each quarter to ensure that they are performing adequately under the Quality Monitoring standard. Dudash makes an initial determination if there were any Reviewer errors in a case. She often checks her determinations with others to make sure that it is not just a difference in opinion. If there were many errors and it might affect an employee's rating, she would discuss the situation with her boss. When there is disagreement, RQAS have an opportunity to defend their position on a case and they may "go back and forth on rebuttals." If they reach an impasse, however, then the matter goes to her boss.

One of Dudash's goals is to reduce the variability of rates of error between different Reviewers. She wants to make sure that they all are applying the same standards. She indicated that if a Reviewer consistently does not find a lot of errors on patentability, then it might mean that he or she is missing something in the review process.

Dudash was the appellant's supervisor throughout the PIP. She said most of her interaction with the appellant during the PIP was through e-mail correspondence and a few telephone calls. Although she primarily works at home, during the PIP, she was in office in an average of two or three days per week and she would come into the office to meet with the appellant. Ordinarily, she provides feedback to other Reviewers within two weeks. However, she generally tried to get back to the appellant within a few days to a week during the PIP. She believed that she provided him with a lot of feedback during the PIP, in order to assist him to improve.

Dudash indicated that the record evidence contains what work the appellant accomplished during the PIP. He reviewed 139 cases, of which 69 were allowances, during that time. Dudash said that she and a colleague, Anthony Caputa (a Supervisory RQAS), reviewed a random sampling of 16 cases that the appellant performed during this time period and they found he committed six errors from that group. She indicated that, in order to choose which cases she reviewed during the PIP, she would simply get a pencil and randomly point it at a case name on the list of cases he was assigned. RAF, Tab 9, Appellant's Exhibit Z.

Dudash described at length the errors the appellant made on several invention applications, including a hand juicer (11/044,913) (Tab 5a); a shower head (10/612,149) (Tab 5b); a quartz plate

(10/891,028) (Tab 5c); an extended release for an additive in a fuel system (10/640,364) (Tab 5d); a multi-layer package for batteries (10/724,596) (Tab 5e); and a copper casting mold (10/463,097) (Tab 5f). In each instance, Dudash disagreed with the appellant's decisions regarding whether there was an error or not. Dudash characterized the mistakes made by the applicant as "flawed," "obvious," and she remarked that it should have been simple for an engineer, such as the appellant, to notice them. She added that he sometimes ignored basic office policies, used poor judgment, and made "bad decisions." She also mentioned that the appellant's write ups at times were "confusing" or he "mischaracterized" what the claims were saying. She expected that a GS-15 employee such as the appellant should have understood the issues and treated them appropriately in these cases. AF, Tab 8, Subtabs 4e, 4h. Dudash pointed out that the appellant's errors were detailed in the proposal letter and that the agency supplied many exhibits to support its allegations of errors. AF, Tab 8, Subtab 4h.

Next, Dudash confirmed that she tried to counsel the appellant on how best to succeed during the PIP. She also encouraged him to talk to his peers if he had any doubts and to avoid working in isolation. Yet, in the end, Dudash believed that she was required to make "way too much revisions" on the appellant's work. She said she had to spend a lot of time sending "too many e-mails back and forth" to him and responding to his "undermining comments" concerning her opinions. Dudash conveyed her frustration about the appellant's work to Caputa.

Ultimately, Dudash concluded that she could no longer trust the appellant's decisions as a Reviewer.

Anthony C. Caputa testified that he is a Supervisory RQAS. He has many years of experience working in several different jobs at the agency. For example, he was a Supervisory Patent Examiner from 1998-2005 and a Patent Examiner from 1993-98. Caputa confirmed that he has taught at the Patent Academy and that some people might consider this to mean he is held in high regard at the PTO. As an RQAS, Caputa reviews his own Reviewers' cases. He estimated that he reviews two of his staff's cases per quarter, which he randomly selects.

Caputa reviewed some of the appellant's work during the PIP after Dudash wrote him and asked him to become involved. *See* RAF, Tab 9, Appellant's Exhibit Z. At first, he recalled looking at "at least one" of the appellant's cases, and he was not sure if he reviewed more than that. Later, he remembered having reviewed about two to five of appellant's cases during the relevant time frame. Caputa could not recall how he determined which of the appellant's cases he should review. Dudash spoke with Caputa about the appellant's work and she showed Caputa a written summary of the results of the appellant's performance under critical element 1 during the PIP. *See* RAF, Tab 10, Appellant's Exhibit LL. Caputa explained that he and Dudash often used each other as "sounding boards" concerning work-related issues.[6]

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[6] Caputa's deposition transcript can be found in the file at RAF, Tab 10, Appellant's Exhibit GG.

Paula Hutzell, OPQA Director, testified that she was the appellant's second-level supervisor. As the current Director, she manages the overall operation of the office. Of the 56 employees in the office, 12 report to her directly.[7]

Hutzell was the proposing official in this case. She did not have a lot of direct contact with the appellant during the PIP. Dudash sometimes sent her e-mails apprising her of the appellant's work. *See* RAF, Tab 10, Appellant's Exhibits HH-JJ. Eventually, Dudash provided Hutzell with a summary of the work the appellant submitted during the PIP. *See id.*, Appellant's Exhibit MM. Hutzell made an independent review of that summary. After her review, she agreed with Dudash's assessment of the appellant's work. She did not see any improvement on the appellant's part during the PIP in the areas that were identified as needing improvement. She also felt that the appellant refused to cooperate with the supervisor. Hutzell reviewed e-mail traffic between the appellant and Dudash, and the feedback from Caputa and David Lacey, who both concurred with Dudash's assessment of all six errors in the appellant's work during the PIP. Hutzell stated that she, too, agreed with Dudash's opinion on these errors and she believed these errors were representative of others she had seen from him over the previous year.

Margaret A. Focarino testified that she is the Deputy Commissioner for Patent Operations. She was the deciding official in this matter. Focarino had regular meetings with Hutzell about the appellant. In making her decision to remove, Focarino reviewed the notice of proposed removal and the oral and written replies to the proposal letter. *See* RAF, Tab 9, Appellant's Exhibit Y. She took notes of the oral reply meeting. *See id.*, Appellant's Exhibit X. She asked Steven Griffin, who was detailed to her office at the time, to review the errors outlined in the notice letter. She believed that Griffin had the requisite technical background to make a fair assessment of the facts presented.[8]

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[7] Hutzell's deposition transcript is located in the file at RAF, Tab 9, Appellant's Exhibit BB.

Steven P. Griffin is a Supervisory Patent Examiner. Griffin, at Focarino's behest, reviewed the six errors the appellant made during the PIP to see if they were reasonable. After spending about six to eight hours reviewing the errors, Griffin concluded that they were reasonable. Griffin said he also considered the comments and explanations the appellant made in his e-mail traffic with Dudash, but did not concur with the appellant's opinions contained therein. Griffin did not know if the six errors identified were representative of the appellant's overall work and he did not review the reply to the notice of proposed removal.[9]

George Elliot testified that he is the former Director of the OPQA. He was the appellant's former second-level supervisor and he signed the appellant's annual performance appraisal in 2004 and his mid-year performance review in 2005. Elliot had little direct involvement with the appellant during that time. The appellant's first-level supervisor would have been more involved in looking at the appellant's performance back then. Elliot, though, believed that the appellant probably deserved the high ratings he received at that time. Elliot reviewed some of the materials the agency used in this case to discipline the appellant. Elliot stated that, based on his review, it appeared that Dudash found errors in the appellant's work and the appellant frequently refused to see Dudash's point of view concerning those mistakes.

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[8] Focarino also was deposed during the processing of the appeal. *See* RAF, Tab 10, Appellant's Exhibit EE.

[9] Griffin's deposition transcript is contained at RAF, Tab 10, Appellant's Exhibit FF.

Robert Hill testified that Dudash asked him to review two of the appellant's cases for her to see if he agreed with her position. Hill did not know if the work products he reviewed were done by the appellant when he was on a PIP. Hill said he agreed with Dudash in one instance and disagreed with her in the other. Hill said he previously reviewed the appellant's performance when he, Hill, was the appellant's supervisor. The appellant received a "Commendable" rating, which Hill considered overly "generous." Hill explained that because the appellant had been receiving "Outstanding" ratings for so long, management at the time decided it "should not go too fast" in giving him downgraded ratings.

Anthony MacFarlane testified that he has worked for the PTO for over 25 years in a variety of positions. He was a Supervisory Patent Examiner. MacFarlane has briefly and generally reviewed some of the appellant's work and he considered the appellant to be a technically competent individual. MacFarlane believed that the appellant was especially knowledgeable in the area of Chemical

Engineering. MacFarlane did not think that Dudash truly allowed any disagreement with her opinion. He could not recall one instance when she reversed herself after making an initial determination of error. Thus, MacFarlane did not feel that Reviewers under her authority were really provided with a right to appeal her decisions. MacFarlane also wrote Dudash and asked her questions regarding how she defined what constituted an error when she reviewed her staff's work. *See* RAF, tab 9, Appellant's Exhibit A.

The appellant, in his testimony, challenged the agency's claim that he had performance difficulties. He emphasized that he has received many "Outstanding" performance ratings during his 25-year history of Federal service and said that he had received numerous commendations and awards during his career. RAF, Tab 9, Appellant's Exhibit P. The appellant reviewed the agency's claims of error. He disagreed that these matters constituted clear errors and he believed that they merely represented his differences of opinion with Dudash, his supervisor. He admitted that he made mistakes and that there was room for improvement, which was true for everybody.

According to the appellant, Reviewers used to be able to talk directly to their Directors. However, after that the office policy changed, and the appellant instead had to talk with Dudash, who became his supervisor in 2004. Initially, he and Dudash got along well. However, she gradually began to try and enforce her own decisions on him, which he believed were at variance with the agency's Manual of Patent Examining Procedure. RAF, Tab

17 (Appellant's Hearing Exhibit No. 3). He also believed that Dudash was targeting him because his work was reviewed much more than other employees.

The agency provided the appellant with a reasonable opportunity to improve performance.

The agency must establish that it provided the appellant a reasonable time to improve his performance. The Board has held that employees have a substantive right to an improvement period before the institution of a performance-based action, and that the agency must show by substantial evidence that the employee was given a reasonable opportunity to improve his performance. *See Gjersvold v. Department of the Treasury*, 68 M.S.P.R. 331, 335 (1995).

It is uncontroverted that Dudash met many times with the appellant, and Hutzell met with him twice, to discuss the PIP and his work deficiencies. Dudash also informed the appellant of his performance problems in a steady stream of e-mails during the PIP. Dudash and Hutzell, moreover, provided convincing testimony that the appellant was advised frequently about his deficiencies and about how he could improve his work products. I find the testimony of Dudash and Hutzell on the appellant's performance deficiencies to be credible, straightforward, persuasive, and consistent with the voluminous documentary evidence of the record. *Hillen v. Department of the Army*, 35 M.S.O.R. 453, 458 (1987) (factors that an administrative judge considers when making credibility determination). Dudash's and Hutzell's testimony on the appellant's performance deficiencies also described very specific and detailed instances of tasks that were poorly done and that he did not easily follow his supervisor's recommendations.[10] I find that Dudash's and Hutzell's testimony on this was supported by the testimony of Hill, who agreed that, from his perspective, the appellant's performance was something less than extraordinary.

I think it is extremely unfortunate that the agency could not have found another position for the appellant, who seems to have many talents and has been a successful Federal employee for most of his lengthy career. It is possible that reasonable persons could disagree on whether the appellant accomplished some of his tasks during the PIP satisfactorily. Nevertheless, the agency's burden of proof in a case such as this is not very high. Based on the documentary and testamentary evidence of the record, I find the agency established by substantial evidence that the opportunity period provided the appellant with a reasonable opportunity to improve his performance on critical element 1 and that he failed to do so. Accordingly, the agency has met its requisite burden of proof on these issues. *See Goodwin v. Department of the Air Force*, 75 M.S.R.P. 204, 208 (1997).

I find that the agency's evidence, consisting, *inter alia*, of its detailed documents and the credible testimony of Dudash, Hutzell, Caputa, Focarino, Griffin, and Hill, constitutes substantial evidence that the appellant's performance in critical element 1 was unacceptable during the PIP. *DePauw v. U.S. International Trade Commission*, 782 F.2d 1564, 1566-67 (Fed. Cir.), *cert. denied*, 479 U.S. 815 (1986). Therefore, I find that the agency has supported its charge of the appellant's unacceptable performance under this critical element.

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[10] Kay Kim another former supervisor of the appellant's from May 10 through August 11, 2005, furnished an affidavit, in which she averred that, while she was temporary director of the office, she reviewed the appellant's work and he "seemed defensive and resistant to my suggestions and recommendations." RAF, Tab 9, Appellant's Exhibit U at p. 3.

The appellant bears the burden of proving his affirmative defenses by a preponderance of the evidence.

Notwithstanding my findings that the agency has supported its charge by preponderance evidence, the agency's action may not be sustained if he shows that the action was based on harmful error of a prohibited personnel practice. 5 U.S.C. § 7701(c). The appellant alleged that the agency, in taking the action, committed harmful error. He also claimed that the agency discriminated against him on the basis of his race (Indian), national origin (Indian), religion (Hindu), and age (over 40 years of age). In addition, he asserted that the agency retaliated against him for his prior equal opportunity (EEO) activity. The appellant bears the burden of proving these affirmative defenses by preponderant evidence. 5 C.F.R. § 1201.56(c)(3).

The appellant failed to establish that the agency committed harmful error.

The appellant argued that the agency's action was not in accordance with law and amounted to harmful error. In particular, he asserted that the agency violated laws when it only reviewed 16 out of the 139 cases he finished during the PIP. That, he argued, was not a fair and adequate sampling. Likewise, he alleged that, when his supervisor reviewed a random sampling of his work, containing only work from the first half of the PIP, this could not have shown any possible improvement. RAF, Tabs 7, 11.

Harmful error under 5 U.S.C. § 7701(c)(2)(A) cannot be presumed; an agency error is harmful only where the record shows that the procedural error was likely to have caused the agency to reach a conclusion different from the one it would have reached in the absence or cure of the error. *See Stephen v. Department of the Air Force*, 47 M.S.P.R. 672, 681, 685 (1991).

I am not sure that the appellant's assertion here is appropriately considered as a harmful error allegation. In fact, his claim seems to constitute no more than a rehashing of his arguments against the merits of the charge of unacceptable performance. To that end, I find that the claim of harmful error is groundless. As I determined in my assessment of the documentary evidence, above, the agency carefully followed its procedures when it placed him on a PIP and then removed him.

That being said, the appellant, in support of his harmful error allegation, provided the testimony of Dhirendra N. Ghosh,[11] a survey/mathematical statistician, who stated that the sampling used to review the appellant's work during the PIP was "not significant enough." Ghosh hesitated to say what number of cases would be acceptable for a random sampling, but estimated it to be about 40-50 cases.

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[11] Ghosh supplied a copy of his curriculum vitae. AF, tab 9, Appellant's Exhibit AA.

Ghosh stated that he did not approve of Dudash's "pencil to paper" methodology of randomly selecting the appellant's cases for reviews. Ghosh deemed the sample as "biased" because all of the appellant's work products reviewed were from the first half of the PIP. When Ghosh was informed that the parties stipulated that the appellant did not submit any work during the last half of the PIP, and that was the reason the samples were all taken from the first half, Ghosh dramatically changed his mind and stated that, if that was the case, then the work reviewed was more likely to be "statistically significant" for the first half of the PIP.

I can find no law, rule, or regulation that requires an agency to use a scientifically and statistically approved methodology to randomly choose work products reviewed during a PIP before it removes him for poor performance. In addition, under the facts of this case, it would have been difficult for the agency to choose a random sampling of cases from the second half of the PIP, inasmuch as the appellant did not produce any work product in the last six weeks of the PIP.

Even assuming the truth of the appellant's assertion that the agency's action was harmful, he has presented no evidence to show that this error would likely have caused the agency to reach a conclusion different from the one it would have reached in the absence or cure of the error. Hence, I find that the appellant has not established that the agency committed error, that he has been harmed, or that the adverse action should be reversed. *See*

Kendricks v. Department of Veterans Affairs, 79 M.S.P.R. 510, 517 (1998); *Baracco v. Department of Transportation*, 15 M.S.P.R. 112, 123 (1983), *aff'd*, 735 F.2d 488 (Fed. Cir.), *cert. denied*, 469 U.S. 1018 (1984).

The appellant failed to establish his allegation of discrimination.

The appellant alleged that the agency discriminated against him based on his race (Indian), national origin (Indian), religion (Hindu), and age (over 40 years of age). RAF, Tab 15. the agency denied these allegations. *See id.*, Tab 16. To establish a claim of prohibited employment discrimination, the employee first must establish a *prima facie* case; the burden of going forward then shifts to the agency to articulate a legitimate, nondiscriminatory reason for its action; and, finally, the employee must show that the agency's stated reason is merely a pretext for prohibited discrimination. *McDonnell Douglas Corp. v. Green*, 411 U.S. 792, 802-04 (1973). In order to demonstrate a *prima facie* case of discrimination, the appellant is required to show that: (1) he is a member of a protected group; (2) he was similarly situated to an individual who was not a member of the protected group; and (3) he was treated disparately compared to the nonmember. *See Stenmark v. Department of Transportation*, 59 M.S.P.R. 462, 471 (1993).

I find that the appellant established that he is a member of a protected group, based on his race, national origin, religion, and age. Thus, he proved one element of a *prima facie* case. As support of his discrimination claim, the appellant testified that he felt he had been singled out and targeted for discipline. I find, however, that the appellant failed to establish that he was similarly situated to any identified employee. *See Richard v. Department of Defense,* 66 M.S.P.R. 146, 153 (1995) (in order for comparison to be considered similarly situated, all relevant aspects of the appellant's situation must be nearly identical to those of the comparison employees). Also, Focarino, the deciding official, and Hutzell, the proposing official, categorically denied that the appellant's race, national origin, religion, or age played any factor whatsoever in their decisions. In fact, these two individuals stated that they were not even sure what the appellant's race, national origin, religion, or age were. Therefore, I find, based on my review of the evidence, that the appellant did not prove that he was discriminated against based on his race, national origin, religion, or age. *See St. Mary's Honor Center v. Hicks*, 509 U.S. 502, 515-16 (1993).

Moreover, even assuming that the appellant had established a *prima facie* case of race, national origin, religion, or age discrimination, I find that the agency articulated a legitimate, nondiscriminatory reason for its action, namely, the appellant's poor performance. The appellant has not shown that the agency's charge of poor performance was false or a pretext for race, national origin, religion, or age discrimination. Thus, I find that he failed to meet his burden of proving his affirmative defense of discrimination. *See Snell v. U.S. Postal Service*, 82 M.S.P.R. 674, 677 (1999); *Womack v. U.S. Postal Service*, 70 M.S.P.R. 285, 293, *aff'd*, 99 F.3d 1160 (Fed. Cir. 1996) (Table).

The appellant has not shown that the agency's action was taken in reprisal for his previous EEO activity.

The appellant contended that the agency's action was taken in reprisal for his previous EEO activity. To demonstrate reprisal, the appellant must show that: (1) he engaged in protected activity; (2) the proposing and/or deciding officials knew of this activity; (3) the adverse action under review could, under the circumstances, have been retaliation; and (4) there was a genuine nexus between the retaliation and action taken. *See Warren v. Department of the Army*, 804 F.2d 654, 656-58 (Fed. Cir. 1986); *McMillan v. Department of the Army*, 84 M.S.P.R. 476, 483 (1999). An employee's protected activity must be established by preponderance evidence to be the "motivating factor" or the "real factor" for the agency's decision. *See Gerlach v. Federal Trade Commission*, 9 M.S.P.R. 268, 274 (1981).

In the instant case, it is undisputed that the appellant filed previous EEO complaints against agency officials. In particular, the parties stipulated that the appellant engaged in protected activity by filing a formal EEO complaint in 2005, after he received an "Unsatisfactory" rating from Dudash and Hutzell. The rating is now the subject of a formal EEO complaint in EEOC Case No-570-2007-00188X (Agency Case No. 06-56-32). *See* AF, Tab 4, Exhibits A-H; *see also* RAF, Tab 12. However, Dudash testified that prior to the PIP and before she drafted the notice of proposed removal, she was unaware of the appellant's prior EEO activity. Focarino testified that she believed the appellant may have filed a prior EEO complaint, but that this had no influence on her decision to remove.

Based on the above, I find that the appellant has not satisfied the first element of the reprisal test as to Dudash, but she [appellant, he] has as to Focarino. In any event, even assuming that both the proposing and deciding officials had known of the appellant's prior EEO activity and so the adverse action under review could, under the circumstances, have been retaliation, I still find that the appellant failed to establish the requisite nexus.

In order to determine whether the appellant has established nexus in a case involving retaliation for engaging in EEO activity, the Board must balance the intensity of the motive to retaliate against the gravity of the misconduct. *Dorsey v. Department of the Air Force*, 78 M.S.P.R. 439, 450 (1998). Here, other than the appellant's bare assertion that the action constituted retaliation, she [appellant, he] presented no direct evidence that her [appellant's, his] removal by retaliatory animus, nor was there sufficient circumstantial evidence to support a finding of genuine nexus between the alleged retaliation and the removal action. The proposing and deciding officials articulated legitimate reasons for taking the action against the appellant. They considered his performance deficiencies to be serious. They further noted that, despite efforts to try to assist the appellant to improve his performance, he continued to fail and he refused to cooperate with these efforts. Based on the record evidence, I find that the appellant has failed to show that his protected activity was the "motivating" or "real factor" for the agency's decision to remove him. Consequently, this affirmative defense must fail.

The appellant's removal must be affirmed.

The agency's removal decision must be upheld once the Board determines the agency has met its burden of proof by demonstrating the appellant performed unacceptably in at least one critical element. *See Cook v. Equal Employment Opportunity Commission,* 50 M.S.P.R. 660, 662 (1991) (the Board may not mitigate a performance-based action). Here, because the agency proved by substantial evidence that the appellant performed unacceptably in a critical element of hid GS-15 Patent Review Quality Assurance Specialist position, the removal must be upheld.

DECISION

The agency's action is AFFIRMED.

FOR THE BOARD: s/ Daniel Madden Turbitt
Administrative Judge

NOTICE TO PARTIES CONCERNING SETTLEMENT

The date that this initial decision becomes final, which is set forth below, is the last day that the administrative judge may vacate the initial decision in order to accept a settlement agreement into record. *See* 5 C.F.R. § 1201.112 (a)(5).

NOTICE TO APPELLANT

This initial decision will become final on AUG 31 2007, unless a petition for review is filed by that date or the Board reopens the case on its own motion. This is an important date because it is usually the last day on which you can file a petition for review with the Board. However, if you prove that you received this initial decision more that 5 days after the date of issuance, you may file a petition for review within 30 days after the date you actually receive the initial decision. You must establish the date on which you received it. The date on which the initial decision becomes final also controls when you can file a petition for review with the Equal Employment Opportunity Commission (EEOC) or with a federal court. The paragraphs that follow tell you how and when to file with the Board, the EEOC, or the federal courts. These instructions are important because if you wish to file a petition, you must file it within the proper time period.

BOARD REVIEW

You may request Board review of this initial decision by filing a petition for review. Your petition for review must state your objections to the initial decision, supported by references to applicable laws, regulations, and the record. You must file your petition with:

The Clerk of the Board
Merit Systems Protection Board
1615 M Street, NW
Washington, DC 20419

A petition for review may be filed by mail, facsimile (fax), personal or commercial delivery, or electronic filing. A petition for review submitted by electronic filing must comply with the regulations of 5 C.F.R. § 1201.14, and may only be accomplished at the Board's e-Appeal website (https://e-appeal.mspb.gov).

If you file a petition for review, the Board will obtain the record in your case from the administrative judge and you should not submit anything to the Board that is already part of the record. Your petition must be filed with the Clerk of the Board no later than the date this initial decision becomes final, or if this initial decision is received by you more than 5 days after the date of issuance, 30 days after the date you actually receive the initial decision. If you claim that you received this decision more than 5 days after its issuance, you have the burden to prove to the Board the date of receipt. You may meet your burden by filing evidence and argument, sworn or under penalty of perjury (*see* 5 C.F.R. Part 1201, Appendix 4) to support your claim. The date of filing by mail is determined by the postmark date. The date of filing by fax or e-mail is the date of submission. The date of filing by personal delivery is the date on which the Board receives the document. The date of filing by commercial delivery is the date the document was delivered to the commercial delivery service. Your petition may be rejected and returned to you if you fail to provide a statement of how you served your petition on the other party. If the petition is filed by e-mail, and the other party has elected e-Filing, including the party in the address portion of the e-mail constitutes a certificate of service.

EQUAL EMPLOYMENT OPPORTUNITY COMMISSION REVIEW

If you disagree with the Board's final decision on discrimination, you may obtain further administrative review by filing a petition with the EEOC no later than 30 calendar days after the date this initial decision becomes final. The address of the EEOC is:

Office of Federal Operations
Equal Employment Opportunity Commission
P.O. Box 19848
Washington, D.C. 20036

JUDICIAL REVIEW

If you do not want to file a petition with the EEOC, you may ask for judicial review of both the discrimination and nondiscrimination issues by filing a civil action. If you are asserting a claim under the Civil Rights Act or under the Rehabilitation Act, you must file your appeal with the appropriate United States district court as provided in 42 U.S.C. § 2000e-5. If you file a civil action with the court, you must name the head of the agency as the defendant. *See* 42 U.S.C. § 2000e-16(c). To be timely, your civil action under the Civil Rights Act, 42 U.S.C. § 2000e-16(c) must be filed no later than 30 calendar days after the date this initial decision becomes final. If you are asserting a claim under the Age Discrimination in Employment Act, you claim must be filed with the appropriate United States district court as provided in 29 U.S.C. § 633a(c). In some, but not all districts you may have up to 6 years to file such a civil action. *See* 28 U.S.C. § 2401(a).

If you choose not to contest the Board's decision on discrimination, you may ask for judicial review of the nondiscrimination issues by filing a petition with:

The United States Court of Appeals
for the Federal Circuit
717 Madison Place. NW.
Washington, DC 20439

You may not file your petition with the court before this decision becomes final. To be timely, your petition must be received by the court no later than 60 calendar days after this initial decision becomes final.

If you need further information about your rights to appeal this decision to court, you should refer o the federal law that gives you this right. It is found in Title 5 of the United States Code, section 7703 (5 U.S.C. § 7703). You may read this law, as well as review the Board's regulations and other related material, at our website, http://www.mspb.gov. Additional information is available at the court's website, http://fedcir.gov/contents.html. Of particular relevance is the court's "Guide for pro se Petitioners and Appellants," which is contained within the court's Rules of Practice, and Forms 5, 6, and 11.

NOTICE TO AGENCY/INTERVENOR

The agency or intervenor may file a petition for review of this initial decision in accordance with the Board's regulations.

SUPPLEMENTAL APPENDIX B

Amendment (Erratum) to the Initial Decision of the Administrative Judge Merit Systems Protection Board (True Copy)

UNITED STATES OF AMERICA
MERIT SYSTEMS PROTECTION BOARD
WASHINGTON REGIONAL OFFICE

ASOKKUMAR PAL Appellant, v. DEPARTMENT OF COMMERCE Agency	DOCKER NUMBER DC-0432-07-0158-1-2 DATE: July 31, 2007

ERRATUM

Two pages from the initial decision, dated July 28, 2007, contained minor errors. Attached are: (1) the first two paragraphs from page 20 [page 25 in this True Copy]; and (2) the second full paragraph from page 23 [pages 29-30 in this True Copy], with the corrections noted.

FOR THE BOARD: s/ Daniel Madden Turbitt
Administrative Judge

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Ghosh stated that he did not approve of Dudash's "pencil to paper" methodology of randomly selecting the appellant's cases for review. Ghosh deemed the sample as "biased" because all of the appellant's work products reviewed were from the first half of the PIP. When Ghosh was informed that the parties stipulated that the appellant, during the last half of the PIP, did not submit any work of the type that Dudash normally reviewed for GS-15 RQAS employees, and that was the reason the samples were all taken from the first half, Ghosh dramatically changed his mind and stated that, if that was the case, then the work reviewed was more likely to be "statistically significant" for the first half of the PIP.

I can find no law, rule, or regulation that requires an agency to use a scientifically and statistically approved methodology to randomly choose work products reviewed during a PIP before it removes him for poor performance. In addition, under the facts of this case, it would have been difficult for the agency to choose a random sampling of cases from the second half of the PIP, inasmuch as the appellant did not produce any work product of the kind that ordinarily warranted supervisory review in the last six weeks of the PIP.

[Appellant's note: These paragraphs, appearing in the initial decision at page 20, now appear at page 25, as the first and second full paragraphs in this True Copy.]

In order to determine whether the appellant has established nexus in a case involving retaliation for engaging in EEO activity, the Board must balance the intensity of the motive to retaliate against the gravity of the misconduct. *Dorsey v. Department of the Air Force*, 78 M.S.P.R. 439, 450 (1998). Here, other than the appellant's bare assertion that the action constituted retaliation, he presented no direct evidence that his removal was motivated by retaliatory animus, nor was there sufficient circumstantial evidence to support a finding of genuine nexus between the alleged retaliation and the removal action. The proposing and deciding officials articulated legitimate reasons for taking the action against the appellant. They considered his performance deficiencies to be serious. They further noted that, despite efforts to try to assist the appellant to improve his performance, he continued to fail and he refused to cooperate with these efforts. Based on the record evidence, I find that the appellant has failed to show that his protected activity was the "motivating" or "real factor" for the agency's decision to remove him. Consequently, this affirmative defense must fail.

[Appellant's note: This paragraph, appearing in the initial decision at page 23, now appears at pages 29-30, as the second paragraph in this True Copy.]

SUPPLEMENTAL APPENDIX C

Final Order
Merit Systems Protection Board
(True Copy)

UNITED STATES OF AMERICA
MERIT SYSTEMS PROTECTION BOARD

ASOKKUMAR PAL Appellant, v. DEPARTMENT OF COMMERCE Agency	DOCKER NUMBER DC-0432-07-0158-1-2 DATE: February 6, 2008

John J. Rigby, Esquire, Arlington, Virginia, for the appellant.

Sonya Pass, Esquire, Arlington, Virginia, for the agency.

BEFORE

Neil A. G. McPhie, Chairman
Mary M. Rose, Vice Chairman
Barbara J. Sapin, Member

FINAL ORDER

The appellant has filed a petition for review in this case asking us to reconsider the initial decision issued by the administrative judge. We grant petitions such as this one only when significant new evidence is presented to us that was not available for consideration earlier or when the administrative judge made an error interpreting a law or regulation. The regulation that establishes this standard of review is found in Title 5 of the Code of Federal Regulation, section 1201.115 (5 C.F.R. § 1201.115).

After fully considering the filings in this appeal, we conclude that there is no new, previously unavailable, evidence and that the administrative judge made no error in law or regulation that affects the outcome. 5 C.F.R. § 1201.115(d).* Therefore, we DENY the petition for review. The initial decision of the administrative judge is final. This is the Board's final decision in this matter. 5 C.F.R. § 1201.113.

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* The appellant notes in his petition for review that the initial decision stated that the performance improvement plan required him to reach the "fully successful" level of not exceeding an error rate of 25%. Petition for Review File, Tab 1 at 28; Initial Decision at 8. However, the initial decision simply contains an error in language because the 25% error rate was the lowest acceptable performance level, "marginal," not the higher "fully successful" level. The agency properly held the appellant only to the lower "marginal" standard of a 25% error rate.

NOTICE TO THE APPELLANT REGARDING YOUR FURTHER REVIEW RIGHTS

You have the right to request further review of this final decision.

Discrimination Claims: Administrative Review

You may request the Equal Employment Opportunity Commission (EEOC) to review this final decision on your discrimination claims. *See* Title 5 of the United States Code, Section 7702(b)(1) (5 U.S.C. § 7702(b)(1)). You must send your request to EEOC at the following address:

Equal Employment Opportunity Commission
Office of Federal Operations
P.O. Box 19848
Washington, DC 20036

You should send your request to EEOC no later than 30 calendar days after your receipt of this order. If you have a representative in this case, and your representative receives this order before you do, then you must file with EEOC no later than 30 calendar days after receipt by your representative. If you choose to file, be very careful to file on time.

Discrimination and Other Claims: Judicial Action

If you do not request EEOC to review this final decision on your discrimination claims, you may file a civil action against the agency on both your discrimination claims and your other claims in an appropriate United States district court. *See* 5 U.S.C. § 7703(b)(2). You must file your civil action with the district court no later than 30 calendar days after your receipt of this order. If you have a representative in this case, and your representative receives this order before you do, then you must file with the district court no later than 30 calendar days after receipt by your representative. If you choose to file, be very careful to file on time. If the action involves a claim of discrimination based on race, color, religion, sex, national origin, or a disabling condition, you may be entitles to representation by a court-appointed lawyer and to waiver of any requirement of prepayment of fees, costs, or other security. *See* 42 U.S.C. § 2000e5(f); 29 U.S.C. § 794a.

Other Claims: Judicial Review

If you do not want to request review of this final decision concerning your discrimination claims, but you do want to request review of the Board's decision without regard to your discrimination claims, you may request the United States Court of Appeals for the Federal Circuit to review this final decision on other issues in your appeal. You must submit your request to the court at the following address:

United States Court of Appeals
For the Federal Circuit
717 Madison Place, N.W.
Washington, DC 20439

The court must receive your request for review no later than 60 calendar days after your receipt of this order. If you have a representative in this case, and your representative receives this order before you do, then you must file with the court no later than 60 calendar days after receipt by your representative. If you choose to file, be very careful to file on time. The court has held that normally it does not have the authority to waive this statutory deadline and that filings that do not comply with the deadline must be dismissed. *See Pinat v. Office of Personnel Management*, 931 F.2d 1544 (Fed. Cir. 1991).

If you need further information about your right to appeal this decision to court, you should refer to the federal law that gives you this right. It is found in Title 5 of the United States Code, section 7703 (5 U.S.C. § 7703). You may read this law, as well as the Board's regulations and other related material, at our website, http://www.mspb.gov. Additional information is available at the court's website, www.cafc.uscourts.gov. Of particular relevance is the court's "Guide for Pro Se Petitioners and Appellant," which is contained within the court's Rules of Practice, and Forms 5, 6, and 11.

FOR THE BOARD: s/ William D. Spencer
Clerk of the Board

Washington, D.C.